
IN THE
United States Circuit Court of Appeals
FOR THE NINTH CIRCUIT.

No. 9342

DALLAS MACHINE & LOCOMOTIVE
WORKS, INC., a corporation,
vs.
Appellant,

WILLAMETTE-HYSTER COMPANY, a
corporation, and CLARK & WILSON
LUMBER COMPANY, a corporation,
Appellees.

} Appeal from the District
Court of the United
States for the Dis-
trict of Oregon.

Hon.
James Alger Fee,
Judge.

APPELLEES' BRIEF.

FILED

MAR 29 1940

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APPELLEES' BRIEF.

—
FOREWORD.
—

That section of the brief for appellant captioned “INTRODUCTORY STATEMENT” is largely argument. It ignores practically every controlling fact in this case. Since appellant has not properly stated the case, appellees will do so.

The attention of your Honors is invited to the fact that appellant's brief makes no attempt, either as contem-

In this brief emphasis is ours unless otherwise stated.

plated by Rule 20. 2.(d) of this Court, or otherwise, to show error in the duly approved fact findings contained in the Master's report (Tr. p. 54) or the specific Findings of Fact (Tr. p. 144) made by the trial judge. Yet such Master's fact findings and such Findings of Fact by the trial judge, if correct, are conclusive of this case. Consequently, summary affirmance of the decree of the lower court is in order. See page 14 of this brief for a detailed discussion of this proposition.

STATEMENT OF THE FACTS.

Appellant charged appellees with infringement of claim 4 of Gerlinger patent No. 1,457,025 (Ex. Bk. p. 848).

Appellant, a corporation having its principal place of business at Dallas, Oregon, is the owner of the patent in suit. Appellee Willamette-Hyster Company is a corporation having its principal place of business in Portland, Oregon. Its name at one time was Willamette-Ersted Company, and it is the successor to a business in the manufacture and sale of lumber carriers, originated in the year 1926 by Willamette Iron & Steel Works of Portland, Oregon. Appellee Clark & Wilson Lumber Company is a corporation engaged in the lumber business at Linnton, Oregon.

The trial court referred this cause (Tr. p. 52) to its Standing Master in Chancery, who filed a well considered and comprehensive report (Tr. p. 54). Thereafter the cause was exhaustively argued, orally and by briefs, in the trial court, before the Honorable James Alger Fee, who filed a carefully prepared opinion herein (Tr. p. 125). The trial judge also entered an order (Tr. p. 143) setting forth specific Findings of Fact (Tr. p. 144) and Conclusions of Law (Tr. p. 156). The present appeal is from a decree (Tr. p. 160) dismissing the suit.

The patent in suit (Ex. Bk. p. 848) is entitled "Lumber Carrier." It *exhibits* its alleged invention as the same may be applied to an old and well known variety of vehicle known as a straddle truck. But it *claims* such alleged invention in broad and generic language,—language manifestly intended to dominate the subject matter when applied to any truck or other vehicle in the general

nature of a lumber carrier. See particularly claim 4 in suit (Ex. Bk. p. 855).

Examples of straddle trucks which were well known long before the alleged invention of the patent in suit are shown in Ross patent No. 1,209,209, issued December 19, 1916 (Ex. Bk. p. 1203); Ross patent No. 1,271,947, issued July 9, 1918 (Ex. Bk. p. 816); and Overlin patent No. 1,323,719, issued December 2, 1919 (Ex. Bk. p. 1080).

The essential components of a straddle truck are (A) a self-propelled vehicle which is of inverted U shape in transverse section, in order that it may straddle a load, and (B) an elevator for lifting the load for transportation and for depositing same at its destination. The self-propelled vehicle and the elevator constitute a mobile unit, but they function very independently of each other. On this point the trial judge aptly has said:

“All in all, an elevator is a lifting device and a truck is a carrying mechanism. The function of these mechanisms is independent and diverse. While the form of the truck must be modified to accommodate the elevator and the form of the elevator must be changed to ride upon the truck, the essential function of each respective device remains. The union upon one frame is mechanical. The gearing of the respective devices to one power shaft is convenient but functionally incidental. *When these devices were thus conveniently mounted together, the truck performed no new function.* It carried the load and moved backward and forward. *The elevator performed no new function.* It lifted or lowered the load. Although geared to the same power shaft, these diverse devices did not even act simultaneously. The peculiar qualities of a truck and an elevator were not amalgamated to produce a new or different function or result. A mere aggregation was attained.” (Tr. p. 135.)

The patent in suit is concerned only with alleged improvements in an elevator,—an elevator *exhibited* on a straddle truck but *claimed* in the environment of any

"lumber carrier comprising a frame" (see claim 4, in suit; Tr. p. 855).

In the year 1921 Mr. Gerlinger and the plaintiff-appellant company built their first two lumber carriers of the kind comprising a truck and a load elevator. The first of such lumber carriers is exhibited by Gerlinger patent No. 1,422,958 (Ex. Bk. p. 808). That patent, now expired, never has been involved in this suit. The second of such lumber carriers is exhibited by the patent in suit (Ex. Bk. p. 848). Each of such lumber carriers was very unsatisfactory—a failure—as the record shows.

As to the first of such lumber carriers, *i. e.*, the one of the now expired patent, the patentee Mr. Gerlinger frankly admitted that it was *not* satisfactory and had to be rebuilt (Tr. p. 188). The second of such lumber carriers, *i. e.*, the one of the patent here in suit, also was impractical. Only one machine like the patent was ever built, because its operation developed defects (Judge Fee's 5th Finding—Tr. p. 146). That machine was furnished to the Willamette Valley Lumber Company (Tr. pp. 192, 193). Of it counsel for plaintiff-appellant, in this court, says:

"The first rebuilt improved straddle-type carrier was sold by plaintiff to the Willamette Valley Lumber Company October, 1921 (Ib. 192, 193). *But this construction was not found practical.*" (Appellant's Brief, p. 9.)

Thus glaringly it appears that both machines exhibited by the Gerlinger patents were *unsatisfactory* and *impractical*, to say the least.

Late in 1922 or early in 1923 plaintiff-appellant abandoned all pretense of operating under the patent in suit and started to make and sell lumber carriers comprising hydraulic elevators (Tr. p. 227). These hydraulic elevators are radically and fundamentally different from the

elevators of the lumber carriers with which this suit is concerned (Tr. p. 232).

The accused lumber carrier is *superficially similar* to the machine of the patent in suit in the same respects that the machine of the patent in suit is similar to the prior art. But the accused lumber carrier *differs* from the machine of the patent in suit in the same respects that the machines of the prior art differ from the machine of the patent. Therefore, appellees contend, and the trial court held, that appellees' lumber carrier does not infringe the patent claim in suit when such claim is construed and interpreted in such charitable manner as to avoid the prior art (Tr. p. 157). Appellees contend, and the trial court held, that the prior art very plainly and very completely anticipates such claim as written (Tr. p. 157).

Plaintiff-appellant continued to make and sell hydraulic elevator lumber carriers, to the exclusion of all others, until some time in the year 1929 (Tr. p. 255).

Meanwhile, (A) defendant-appellee Clark & Wilson Lumber Company, in the year 1923, began, and thereafter continued, to buy and use, and sometimes to build for itself, lumber carriers of the character now charged to infringe the patent in suit, and (B) Willamette Iron & Steel Works, predecessor of defendant-appellee Willamette-Hyster Company, started, in the year 1926, a business in lumber carriers of the character now charged to infringe the patent in suit,—that business which has been continued by Willamette-Hyster Company down to the present day.

Then, in October 1935, plaintiff-appellant, which knowingly, silently and uncomplainingly had stood by for *twelve years* in the case of Clark & Wilson Lumber Company, and for nearly *nine years*, in the case of Willamette-Hyster Company, filed this suit.

Naturally, the defense of laches was pleaded and urged on behalf of both defendants. That defense was sustained (Tr. p. 142).

On the subject of laches the Master, beginning at Tr. p. 79, said:

“LACHES.

In view of the Master's conclusion with regard to infringement, it may seem unnecessary to discuss the question of laches. But, in view of the fact that the court may not approve the Master's finding and recommendation in that respect, he begs leave to report to the court his findings, conclusions and recommendations upon the subject of *undue and inequitable delay*.

Gerlinger's patent in suit, No. 1457025, issued May 29, 1923, on his application filed March 30, 1922. His bill of complaint herein was exhibited October 3, 1935.

As early as *September, 1923*, the defendant Clark & Wilson Lumber Company had purchased two Ross carriers, both of which have been in constant use ever since. These Ross carriers are of a straddle type with load-lifting means mounted in the frame, the lift is positive from four points working in unison; it has a clutch manually operated, which can be placed in neutral, and when in operative position moves the lift in either direction; it has means which, when the lift has reached a pre-determined point in upward or downward movement, throw the clutch into neutral and apply a brake to the load-lifting means. The upward movement is not controlled by the movement of the load. The type of means adopted by Ross differs somewhat in construction from that employed by Gerlinger and from that employed by the defendant Willamette-Hyster Company, but efficiently achieves the desired result. *If defendant Willamette-Hyster Company, infringes Gerlinger, so does Ross.* The [allegedly] infringing device in suit was first designed and constructed by the Willamette Iron & Steel Company in September, 1926. The defendant Willamette-Hyster Company succeeded to the carrier business of

the former in 1929, and both companies, during their respective periods of operation, *continuously manufactured and sold* the alleged infringing device. The gross amount of defendant's sales of the alleged infringing carrier are approximately \$2,000,000.00.

At least as early as December, 1925 (Exhibit 22) the Ross carrier company advertised its carrier in trade journals, such as 'The Timberman', where it was claimed 'The hoist is positive and uniform at all four POINTS of lift. Automatic cut-outs are provided to prevent damage by unskilled operators'. To the user and to the Ross Company's competitors this could mean but one thing, namely, that means had been provided for automatically disconnecting the source of power from the load-lifting mechanism.

Ross' advertisement in The Timberman of November, 1926, is even more specific. It is there said:

'POWER TAKE OFF.'

In constant mesh with transmission gear. *Connected to hoisting mechanism by single disc dry plate clutch, which is controlled by single hand lever for starting and stopping hoist in either direction. Equipped with automatic brake of ample size. Load may be raised or lowered while carrier is in motion. Hoist stops automatically at upper and lower limit of travel.*' (Italics mine.)

Such language, to the trade and to Ross' competitors, is susceptible of but one meaning,—namely that the hoist mechanism had a clutch for connecting and disconnecting the load lifting means from the source of power; that it had an automatic brake and that means were provided for disconnecting the source of power from the hoist at pre-determined points of upward and downward movement.

Gerlinger and the other officers of the plaintiff insist that they had no knowledge that either Ross or Willamette Hyster employed automatic means for disconnecting power from the hoist and automatically applying a brake. Except for the testimony of G. A. Grab, the managing director of the carrier department of the defendant Willamette Hyster Company, there is no DIRECT proof that they had such knowledge. Grab was employed by Gerlinger and the plaintiff

from 1921 to January 1, 1926. He was in charge of its sales and service. He claims that shortly after Clark & Wilson purchased Ross carriers in 1923 he inspected them, observed automatic stops and brakes and reported same on several occasions to the patentee, Mr. Gerlinger. Certainly it is entirely likely that while so employed by plaintiff he became familiar with the construction of the Ross carrier. *It is difficult to believe that he would not have been sufficiently interested in a competitor's product not to make such inspection and ascertain such facts.* Mr. Gerlinger, however, specifically denies that Mr. Grab ever spoke to him about the stop mechanism of the Ross carrier, although he admits that he may have mentioned the fact that Clark & Wilson had purchased Ross carriers.

When Grab left the employment of plaintiff it is evident that some feeling of hostility existed between Gerlinger and himself. He immediately obtained employment with one of plaintiff's competitors, the Willamette Iron & Steel Company, and he is now a highly interested witness. For these reasons the Master would hesitate to find that Gerlinger had antecedent knowledge of Ross' stop and brake mechanism based solely upon Mr. Grab's testimony.

However, there are other persuasive facts in the record on this subject. *The market for straddle type carriers is comparatively limited.* The competitive field is largely occupied by Ross, Willamette Hyster and plaintiff. *The competition between them is and has been keen.* These carriers are not machines which are hid away or concealed from public and general observation. *In each type of machine the automatic stops are in plain view and the automatic brake is likewise visible to casual inspection, or, at least, its presence is plainly indicated.* When used, these carriers travel through lumber yards and over loading platforms, largely open to the public and certainly to anyone having occasion to visit the mill plant. *They often travel upon the public highways.*

It is difficult to conceive that under such circumstances any competing manufacturer did not have accurate and complete knowledge of the structure employed by the others. *Each proclaimed the superiority of its product, each was necessarily compelled to explain the particular point of alleged superiority of his*

device over those of his competitors; each naturally would be curious as to what the competitor had done and of what the new competing models would consist. To believe that plaintiff and its executive officers, its salesmen and mechanical department, were not fully conversant with the details of the structure of the competing machine is to place a heavy burden upon the Master's credulity. *To fully accept the denial of knowledge compels one to believe and find that plaintiff in this case failed to do what ordinary prudence, business judgment and common sense would dictate, namely, to avail itself of knowledge which was advertised, and of inspections which were easily and readily available.* If it should be conceded that the officers of the company did not know the ACTUAL structural details of Ross and of Willamette-Hyster during all these years, *they must have been aware that the Ross and Willamette-Hyster machines embodied automatic means for throwing the clutch into neutral and applying the brake to the load lifting mechanism, and inasmuch as plaintiff asserts that the patent includes ANY means, it follows that they must have been aware that the Ross and Willamette carriers infringed the patent.*

To use the language of Judge Lurton (sitting with J. J. Taft and Hammond) in *Woodmanse & Hewitt Manufacturing Co. v. Williams*, 68 Fed. 489, 492,—

'Indeed it is not within the range of probability that two rival concerns engaged in selling competitive windmills in the same section of the Union could have been ignorant of the fact that the mills of each contained substantially the same brake mechanism.'

Indulging plaintiff with the possibility that its officers and its assignor might not have had knowledge of defendant Clark & Wilson Lumber Company's alleged infringing use from 1923 until the fall of 1935, still '*there devolves upon a plaintiff the burden of disclosing the impediments to a earlier action; of showing, if ignorant of his rights, how he had remained in ignorance so long.*'

Window Glass Machine Co. v. Pittsburgh Plate Glass Co., 284 Fed. 645, 650.

This burden, in the Master's opinion, plaintiff has not sustained. By failure to give notice of infringe-

ment and failure to act, it has permitted the defendant Clark & Wilson Lumber Company, during this period of at least *twelve years*, to purchase eleven Ross carriers and several Willamette-Hyster carriers, and it has likewise permitted the Willamette-Hyster Company to invest large sums of money in plans, equipment and in the manufacture of its carriers.

The Clark & Wilson Lumber Company is a purchaser and user. Its knowledge of plaintiff's patent is constructive only. As to it, plaintiff has been guilty of laches of such character that even had the Master found infringement, plaintiff would not be entitled to relief either for accounting or by way of injunction against further use. No patentee should be granted relief who has permitted an ultimate user to expend large sums of money in the purchase of infringing machines and to use them without objection over a long period of years without at any time informing such user that the machine so purchased and used was an infringement of the patent.

The Willamette-Hyster Company stands in a somewhat different position; its managing director Grab knew of the existence, the nature and extent of the patent in suit. By this knowledge it is bound. On the other hand, as the Master holds, plaintiff has failed to sustain the burden of proving not only that it was ignorant of the infringement but why and how, under the circumstances, it could be ignorant of it. He finds, therefore, that it had such knowledge. *It knew that the Willamette-Hyster Company was an active competitor in its field, that it was investing large sums of money in the development, manufacture, sale and distribution of its carriers. It permitted the Willamette-Hyster Company so to do, making no objection whatsoever for approximately nine years.* Its laches, therefore, should prevent its obtaining any accounting for losses, gains or profits, even though plaintiff might otherwise be entitled to an injunction against further infringement." (Master's Report, pp. 79-86.)

And the trial judge, in his independent opinion approving the Master's report, beginning at Tr. p. 141, said:

"This brings up the question of laches. It has been proven that plaintiff after the abandonment of the

load actuated stop manufactured a few carriers and then turned to the exclusive manufacture of hydraulic carriers. The advertisements as to the latter carrier and the continuous output by plaintiff indicate that Gerlinger believed these were the last word in carrier construction. At any rate, in a highly competitive field, the plaintiff entirely disregarded manufacture and use of the machines which it now claims were infringements. In 1935 there were two developments. First, plaintiff went back to the manufacture of the rack and pinion carrier. Second, plaintiff heard that the defendant Willamette-Hyster expected to sue it for infringement. Thereupon, it is claimed for the first time a detailed examination of the carriers made or operated by defendants was made by the agents of plaintiff.

There are three parties concerned in a patent suit, the patentee, the alleged infringer and the public. In order to promote invention it is proper to grant a monopoly. It is, however, in the interest of the public that as much of the art as possible be released from monopolistic control. While the characteristic of the patent is such that it is possible to lock up new developments, damage occurs to the public if another person is permitted over a series of years to place devices upon the market, while a patentee sits idly by and takes no action. Sufficient damage is here shown so that the doctrine of laches is applicable. While the case of *Gillons, et al. v. Shell Co. of California*, 86 F. (2d) 600, may have distinguishing features, the principle is applicable here.

Whether or not there was infringement still laches is a complete bar." (Tr. pp. 141, 142.)

With respect to this matter of laches the attention of your Honors is also directed to those specific Findings of Fact of the trial judge which are numbered 24 to 33, both inclusive, and which appear at Tr. pp. 153-156.

Propositions Relied Upon by Defendants-Appellees.

Defendants-appellees contend:

1. That summary affirmance of the lower court decree is in order because of the failure of plaintiff-appellant to show, or to make any plain attempt to show, error in either the fact findings of the Master or the Findings of Fact by the trial judge.
2. That the single claim in suit is void, in view of the prior art, unless limited and restricted to the specific device which the patent exhibits.
3. That the claim in suit, when limited as it must be limited to save it from invalidity, is not infringed by the accused machine of defendants-appellees.
4. That plaintiff-appellant has been guilty of laches—laches so gross as to bar both injunctive and compensatory relief.
5. That the claim in suit is one of the kind denounced by the Supreme Court in *Bassick v. Hollingshead*, 80 L. Ed. 1251, 298 U. S. 415, and in *Lincoln v. Stewart Warner*, 82 L. Ed. 1008, 303 U. S. 545.

ARGUMENT.

Plaintiff-Appellant Now Stands Conclusively Bound by the Fact Findings Appearing in the Master's Report and the Specific Findings of Fact Made by the Trial Judge.

Rule 20 of this Court, which prescribes what an appellant's brief shall contain, provides:

2-d. "In all cases save those of admiralty, or criminal nature, a specification of errors relied upon which shall be numbered and shall set out separately and particularly each error intended to be urged.

* * * In equity and admiralty cases, and at law when findings are made, the specification shall state as particularly as may be wherein the findings of fact and conclusions of law are alleged to be erroneous. When the error alleged is to a ruling upon the report of a master, the specification shall state the exception to the report and the action of the court upon such exception."

Appellant's brief is devoid of the "specification of errors" required by the first sentence of the above quoted excerpt from Rule 20.

And such brief for appellant does not attempt, in any way whatsoever, to "state as particularly as may be" wherein the fact findings in the Master's report, or the specific Findings of Fact made by the trial judge are erroneous, as required by the next to the last sentence of the above quoted excerpt from Rule 20.*

Nor does appellant's brief state any "exception to the report and the action of the court upon such exception" as required by the last sentence of the above quoted excerpt from Rule 20.

* Only on page 40 of appellant's brief do we find even a quibble concerning the correctness of any finding of the court below. On page 40 appellant directs against Judge Fee a criticism of the pin prick variety because His Honor used the word "went" instead of "had gone"—in a situation where the meaning is clear whichever grammatical form is adopted.

If appellant merely had inconvenienced your Honors and appellee by a technical failure to observe the above quoted rule of this Court, your Honors might be inclined charitably to overlook the circumstance, or to discipline appellant by some action short of an outright dismissal of its appeal or a summary affirmance of the decree of the court below.

But the fact is that appellant, in writing its brief, has chosen, for the most part, to IGNORE those fact findings of the duly approved Master's report, and those specific Findings of Fact of the trial judge, which spelled defeat for the plaintiff in the court below.

We have searched appellant's brief in vain for any direct attempt, or any reasonably plain attempt by indirection, to show that any fact finding, contained in the Master's report, or any of the specific Findings of Fact made by the trial judge, is contrary to the evidence in any material respect.

In this situation appellant is in no position to criticize or attack, *either in its reply brief or at the oral argument*, the controlling facts in this case as found and recorded by the duly approved Master's report and the specific Findings of Fact made by the trial judge.

In *Eastman Kodak Co. v. Southern Photo Materials Co.*, 273 U. S. 359, 369; 71 L. ed. 684, 687, the Supreme Court said:

“While many errors were assigned, some of which were also specified, in general terms, in the defendant's brief in this court, we confine our consideration of the case in this opinion to the controlling questions which are stated in that brief to present the chief issues here in controversy, and to which alone the argument in the brief is directed.”

And in *Southeastern Express Co. v. Robertson*, 264 U. S. 541, 542; 68 L. Ed. 840, 841 (1924), in which a state statute, which imposed a privilege tax, had been held constitutional by the trial court, the Supreme Court said:

“The ruling in the latter respect is assailed and as-

signed as error in the record *but not in the argument* and we therefore do not discuss it."

And in *Ewing v. Howard*, 74 U. S. (7 Wall.) 499, 503, 19 L. ed. 293, 295, the Supreme Court said:

"Neither of the objections taken to the action of the circuit court and embodied in the bill of exceptions are urged in this court, and being in themselves entirely untenable, they must be considered as having been abandoned."

And in *United States v. First Wisconsin Trust Co.*, 92 Fed. (2d) 840, 841, the Court said:

"The Government has assigned fifty-two errors, and it claims generally to rely upon all of them. It has discussed but few of them, however, and for that reason those not discussed will be considered as having been waived."

And in *Pickham v. Wheeler-Bliss Mfg. Co.*, 77 Fed. 663, 664, the court said:

"Under the third and fourth heads of the brief are quoted, but without references to the pages of the record where the rulings are shown, specifications of error upon the exclusion of testimony, and upon the giving and refusing of instructions to the jury, but as none of them is supported by argument or citation, or even by a suggestion to enable the court to apprehend the exact question intended to be presented, they must be regarded as waived. There may have been suggestions in support of some of these specifications at the hearing, but it cannot be permitted to the appellant, as a matter of right, to bring forward in the oral argument questions not presented in the brief, and which by reason of the failure to argue them in the brief the other party was entitled to consider waived."

We submit:

1. That the duly approved fact findings of the Master's report, and the specific Findings of Fact made by the trial judge, make out complete defenses for appellee and spell inevitable defeat for appellant.

2. That such fact findings of the Master's report and

such Findings of Fact made by the trial judge are no longer subject to attack—because appellant has elected and chosen not to attack them in its main brief.

3. That in these circumstances the decree of the lower court properly may be and should be affirmed without any study by your Honors of the voluminous testimony and exhibits comprising the record herein.

Infringement Cannot Be Made Out by Comparing the Accused Machine With a Machine Built by Plaintiff-Appellant, Such as the Machine of Plaintiff-Appellant Containing the Lift Control Stops 90 and 91. The Comparison Must Be Between the Accused Machine and the Machine Disclosed and Claimed in the Patent.

Plaintiff-appellant is ashamed of the machine which its patent discloses. It is a machine which counsel for plaintiff-appellant admits “was not found practical” (appellant’s brief p. 9).

Throughout the proceedings in the court below the plaintiff-appellant endeavored to keep its patent in the background and carry on the *pretense* that what Mr. Gerlinger invented and patented was a structure like the drawing, Pl. Ex. 6, and the model, Pl. Ex. 13,—exhibits which contain the stop members 90 and 91 which the disclosure of the patent *lacks*.

In the very first sentence of his brief in this court we find counsel for plaintiff-appellant attempting to renew the same pretense. He says:

“This suit is brought against Appellees (defendants) for their infringement of the patent granted to Carl F. Gerlinger, May 29, 1923, No. 1,457,025, *a model of which may be seen in Pl'ffs. Ex. 13* (Tr. 216), on an improvement in Lumber Carrier of the straddle-type.” (Appellant’s brief, p. 1.)

Such Ex. 13 is not a model of the patent disclosure. It

represents an *afterthought* of Mr. Gerlinger, constructed and operating in accordance with the teachings of the prior art. It represents an afterthought which came to Gerlinger when the patented structure "was not found practical." It contains the stop elements 90 and 91.

In this connection the patentee Gerlinger testified:

"Q. Your answer then is that both the model, Exhibit 13, and the structure shown on the chart, Exhibit 6, have a part marked 91; is that right?

A. Yes.

Q. And your patent here in suit does not show that part 91; is that right?

A. That is right. I mean the patent drawing don't show it." (Tr. p. 221.)

And in this same connection the Master, in his report, said:

"Nos. 90 and 91 will not be found in the drawings or specifications of the patent * * *." (Tr. p. 63.)

We urge that your Honors be not misled by the pretense of plaintiff-appellant that the drawing, Pl. Ex. 6, the model, Pl. Ex. 13, or any other drawing or structure embodying the limit stop elements 90 and 91, is representative of the machine of the patent in suit.

Your Honors will perceive, as you get further into this case, that plaintiff-appellant seeks at all times to distract attention from the bail-like member 67, which is the salient and characterizing element of the patent in suit (see Fig. 3 of the patent in suit, Ex. Bk. p. 853). And while endeavoring to soft pedal the element 67, plaintiff-appellant keeps up the pretense that the limit stop elements 90 and 91 are something within the very dubious contribution to progress (or retrogression) which the patent in suit monopolizes. The reason for such tactics is this:

Appellant and appellees in their present-day successful machines use elements functioning like the prior art limit stops 90 and 91. No one, not even plaintiff-appellant, uses

anything like, or corresponding in function with, the bail-like element 67 of the patent in suit.

The authorities in this and other circuits, are overwhelmingly to the effect that infringement depends, not upon what a patentee has *manufactured*, but upon what he has patented.

"And it is axiomatic in the patent law that infringement depends, not upon what is manufactured or sold by the patentee, but upon what he has patented."

Magnavox Co. v. Hart & Reno et al., 73 Fed. (2d) 433, 445, 446 (C. C. A. 9).

"In passing, I may observe, that some considerable confusion is found in the record, which arises from the fact that counsel, to some extent on both sides, persistently insisted on comparing defendant's accused device with plaintiff's commercial device, instead of comparing the accused device with the teaching of the patents in suit, as disclosed by the specifications and claims, or by the claims as read in the light of the specifications. * * * Experience often discloses that commercial devices, alleged to be protected by a patent, or patents, depart substantially from the patent, or patents, themselves. So, commercial devices are not to be compared with commercial devices, but the accused commercial device is to be compared with the claims of the patent in dispute."

Hartford-Empire Co. v. Obear-Nester Glass Co., 39 Fed. (2d) 769, 771 (C. C. A. 8).

"The test of infringement is, of course, the patent and not the patentee's commercial construction."

Amity Leather Products Co. v. Halvorsen et al., 64 Fed. (2d) 793, 796 (C. C. A. 7).

"It may be true that the cases which appellant (patentee) actually manufactures and markets much more closely resemble the defendant's structure, but its suit is necessarily predicated, not upon what it manufactures, but upon what it has patented."

Grand Rapids Show Case Co. v. Weber Show Case & Fixture Co. et al., 38 Fed. (2d) 730, 731 (C. C. A. 9).

An Explanation of the Color Scheme Which Is Common to All of Defendants' Chart Exhibits Appearing in This Brief.

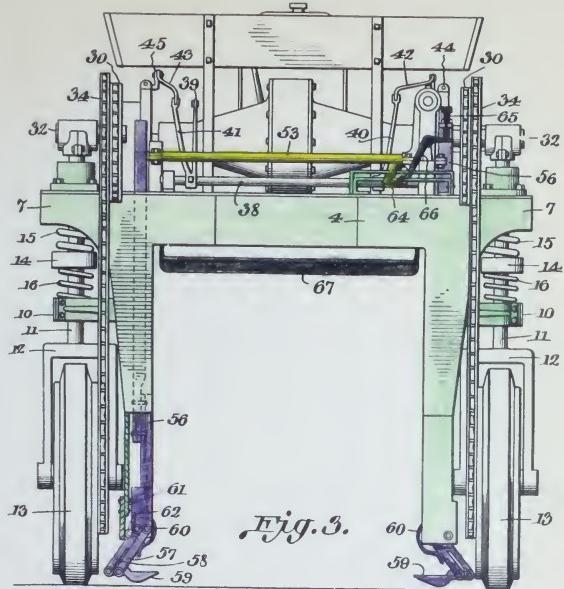
The single claim in suit is couched in broad and comprehensive terms. While the claim recites but six elements, it will be found that certain ones of these elements include much mechanism when the claim is read upon drawings of any given machine. Moreover, it will be found that the specific mechanisms, which respond to the very broadly recited elements of the claim, vary considerably in the several machines (plaintiff's patented machine; the prior art machines; and the accused machine) with which the claim must be compared.

Therefore, our chart exhibits have been uniformly colored in accordance with a plan which will enable your Honors to apply the broad language of the claim to each chart disclosure without going into (any more than you care to do so) the minutia of the structures under consideration.

The claim in suit breaks down as follows:

A lumber carrier comprising

- (a) a FRAME,
- (b) LOAD LIFTING MEANS mounted therein,
- (c) MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction,
- (d) MEANS FOR MANUALLY MOVING THE CLUTCH to operative position,
- (e) AUTOMATIC MEANS FOR MOVING THE CLUTCH to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and



GERLINGER

1,457,025

May 29, 1923.

A lumber carrier comprising

- (a) a FRAME,
- (b) LOAD LIFTING MEANS mounted therein,
- (c) MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction,
- (d) MEANS FOR MANUALLY MOVING THE CLUTCH to operative position,
- (e) AUTOMATIC MEANS FOR MOVING THE CLUTCH to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and
- (f) MEANS FOR BRAKING the transmitting means whenever the clutch is moved to neutral position.

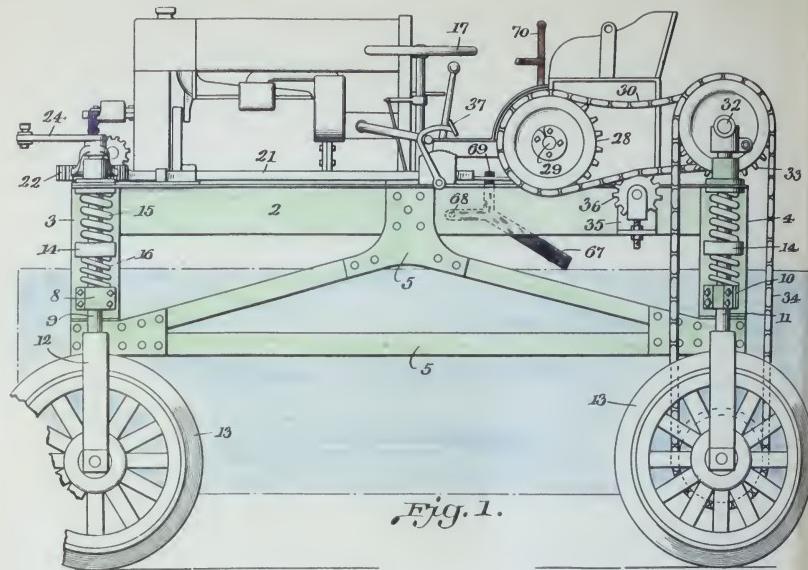


Fig. 1.

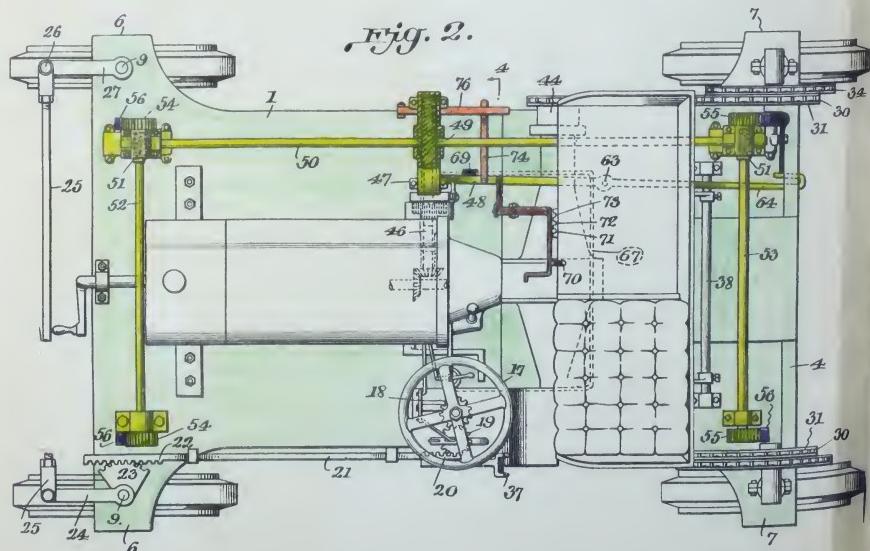


Fig. 2.

(NOTE: The above is Gerlinger's Claim 4 in suit)

(f) MEANS FOR BRAKING the transmitting means whenever the clutch is moved to neutral position.

To each element, as recited by the claim, we have assigned a definite color. And in our charts each instrumentality, or group of instrumentalities, which responds to any given element of the claim bears the color which has been assigned to that element of the claim.

Thus, on each of our charts the machine FRAME is uniformly colored green; the LOAD LIFTING MEANS uniformly is colored purple; the MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS uniformly is colored yellow, etc.

This plan of chart coloring was very useful during the proceedings below, and we hope and trust that it will be helpful to your Honors.

The Machine of the Patent in Suit Has a Peculiar and Undesirable Mode of Operation.

The chart appearing opposite this page corresponds with Defendants' Exhibit 25. It bears Figs. 1, 2, and 3 of the drawings of the Gerlinger patent in suit conveniently disposed adjacent a break-down of the Gerlinger claim in suit.

Before we get into a detailed discussion of this chart, we wish to call your Honors' attention to the bail-like member 67 of Figs. 1 and 2. *This is the part of the patented machine which plaintiff-appellant persistently endeavors to soft pedal.* It is the only part of the patented machine which is not anticipated in the prior art. It finds no counterpart in the accused machine of defendants-appellees. It finds no counterpart in the present-day commercial machines of plaintiff-appellant. It characterizes the patented machine with an unsatisfactory, self-destructive and intolerable mode of operation,—a mode

of operation which is not a characteristic of either the accused machine or defendants-appellees, or the latter-day commercial machines of plaintiff-appellant.

Furthermore, and very important to bear in mind, this bail-like element 67, this unfortunate feature of the patented machine, is one of the things which the trial court found needs must be read into the claim in suit by the court if that claim is to be saved from utter anticipation by the prior art (see Opinion, Tr. p. 135; also trial court's Conclusions 3 and 4, Tr. p. 157).

Applying Gerlinger's claim to the Gerlinger drawings as they appear on the chart, we find the FRAME in the several green colored members of the truck chassis.

We find the LOAD LIFTING MEANS in the purple colored mechanism which appears most clearly in Fig. 3.

This mechanism comprises the four vertically moving rack bars 56, provided at their lower ends with peculiarly shaped shoes 59, which are adapted to engage under a load of lumber and elevate it for transportation when the rack bars are lifted. These shoes deposit the load when the rack bars subsequently are lowered. Your Honors will find, when you compare the patented machine with the accused machine, that the LOAD LIFTING MEANS of the latter is radically different from that of the patent. The LOAD LIFTING MEANS of the elevator forming part of the accused machine comprises neither rack bars nor the peculiarly shaped shoes to which we have alluded.

In the Gerlinger machine, as depicted on the chart the MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS, comprises all of the mechanism colored yellow. Such yellow mechanism includes a reversible clutch 47 (the structure and mode of operation of which are left pretty much to the imagination), shafting 50, worm gearing 51 and shafting 52, 53 whereby to

transmit power from the vehicle power plant to certain gears 54 and 55 which mesh with teeth on the purple rack bars 56. Associated with the clutch is a lever 48 which is said to have three positions, *i. e.*, a first position in which it puts the clutch 47 in neutral, a second position in which it actuates the clutch in such a way as to cause the lifting of the purple elements of the load elevator, and a third position wherein it causes the lowering of such purple elements of the load elevator.

The MEANS FOR MANUALLY MOVING THE CLUTCH comprises the parts in brown shown most clearly in Figs. 1 and 2. These brown parts include a hand lever 70 which is said to be effective to operate on yellow lever 48 to accomplish the placement of the clutch in its neutral position, or in either selected one of its power transmitting positions.

But when we try to find in the Gerlinger patent drawing the red colored AUTOMATIC MEANS FOR MOVING THE CLUTCH of the claim, we run into difficulty. The patent does show means, which is automatic, for moving the clutch, but it is not means for moving the clutch

“to neutral position upon a movement of the load lifting means to a *predetermined extent in either direction*”

as the claim demands. We have here a situation where a patentee has defined an element in language which does not fit his own disclosure,—language, however, which is aptly descriptive of the prior art, as your Honors presently will perceive.

Therefore, we have not seen fit to apply the color red to any of the Gerlinger patent structure appearing on the chart under consideration. On the chart the AUTOMATIC MEANS FOR MOVING THE CLUTCH is shown in black, because it is a means *incapable of functioning* in the manner of the red colored element of the claim.

This black colored clutch moving means comprises the bail-like element 67, to which we have previously alluded as the salient feature of the Gerlinger machine,—the feature which gives the Gerlinger machine its characteristic and intolerable mode of operation. Such black colored clutch moving mechanism also comprises a set screw 65 and a bell crank lever 66, which are most clearly shown in Fig. 3.

The MEANS FOR BRAKING, which is the last element of the claim, is found in the orange colored parts most clearly appearing in Fig. 2 of the chart. None of the witnesses was able to give a very satisfactory “guess” as to how this orange MEANS FOR BRAKING is constructed or how it operates. We may say, however, that it is *supposed* to brake the operation of the parts driven through the reversible yellow clutch 47 when the latter is in its neutral position, and *not* to perform any braking function when the clutch and the other yellow colored mechanism is functioning to drive the purple colored LOAD LIFTING MEANS either upwardly or downwardly.

Now let us see why the machine of the Gerlinger patent has a self-destructive and intolerable mode of operation. The bail-like member 67 is supposed to function (in a manner not entirely clear from the patent drawings or description) to act upon the yellow lever 48 to throw the yellow clutch 47 into neutral position when the bail-like element 67 is engaged and moved upwardly by a load of lumber carried on the shoes 59 of the purple LOAD LIFTING MEANS. But frequently the brown hand lever 70 is actuated to throw the yellow clutch 47 to its load elevating position when there is no load on the shoes 59, or when the load is one of very little height, or when the load is one so piled that it does not engage the bail-like member until after the load has engaged the underside of the green frame. In such cases the yellow components of the lumber carrier just proceed

to destroy the yellow gears 54 and purple rack bars 56,—this being so because power remains supplied to the yellow mechanism at a time when further movement of the purple mechanism can only result in serious injury to the machine.

Your Honors now readily will understand why we have not given any parts of the Gerlinger machine the red color corresponding to element (e) of the claim. The element 67 simply does not function to move the clutch to neutral position upon an *upward movement* of the load lifting means “*to a predetermined extent.*”

When there is no load in the machine the element 67 simply does not function to throw out the clutch—it lets the machine seriously injure itself. Sometimes, even when there *is* a load in the machine, it lets the latter seriously injure itself. Sometimes, when the load is one of considerable height, it functions to throw the clutch to neutral after the purple mechanism is moved to a *minor* “extent” in the upward direction. Sometimes when the load has little height, it functions to throw the clutch to neutral after the purple mechanism is moved to a *major* “extent” in the upward direction. Assuredly the bail-like element 67 is not one functioning to move the clutch to neutral upon a movement of the purple LOAD LIFTING MEANS to a

“*predetermined extent*”

in the upward direction.

The black screw 65 and the black bell crank 66 seem to be, so far as the record shows, a fairly effective means for moving the yellow clutch 47 to its neutral position when the purple LOAD LIFTING MEANS is moved to a predetermined extent in the downward direction. When the purple rack bars 56 reach approximately the position shown in Fig. 3, the screw 65 engages one end of the bell crank 66, as shown in Fig. 3. Thereupon, the other end of such bell

crank engages the turned-back extremity of the rear portion 64 of the yellow lever 48 to throw the clutch to neutral position.

The Law of Mechanical Operation, in Accordance With Which Gerlinger's Patented Machine Must Function, Is That the Stop Governing Upward Movement of the Elevator Shall Be Actuated ONLY by the Load.

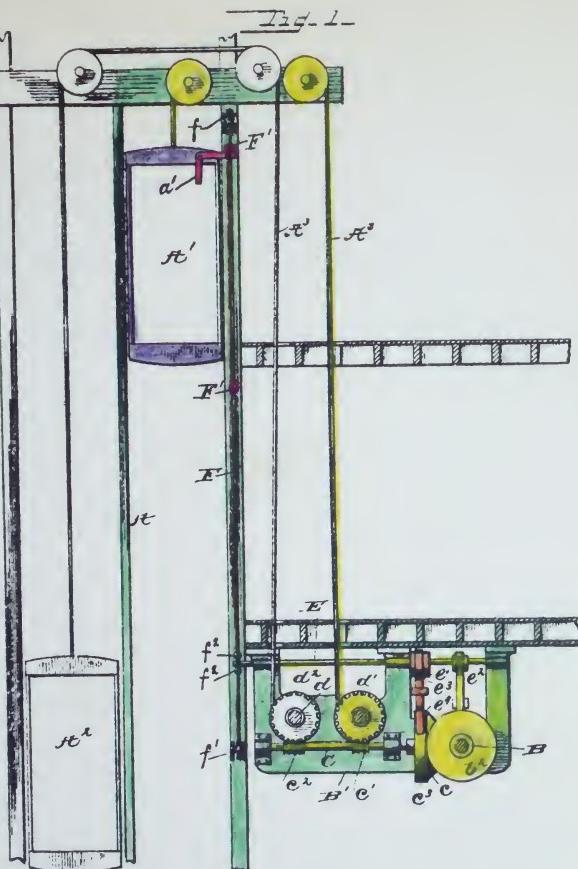
The record herein is overwhelmingly to the effect that the law of mechanical operation, which governs the functioning of the machine of the patent in suit, is that the stop governing upward movement of the elevator shall be actuated *only by the load*.

It will later appear to your Honors that the law of mechanical operation, which governs the functioning of the accused machine of defendants-appellees, is that the stop which governs upward movement of the elevator shall be actuated INDEPENDENTLY of any load and REGARDLESS of whether or not there be any load in the elevator.

With respect to the law of mechanical operation which governs the functioning of the machine of the patent in suit—this law which sentenced such machine to eternal oblivion—the duly approved report of the Master says:

“The plaintiff and the patentee built but one machine containing a load-actuated upward movement stop bar. It had defects which in actual operation became obvious. If the load was not of sufficient height to engage bar 67 by the time the rackbars had reached the end of their normal travel, or if the load was not properly distributed on the lift, bar 67 would not operate and the hoist mechanism would be subject to damage, due to upward movement beyond the designed range, thus either stripping the pinion or the rack teeth.” (Tr. pp. 62, 63.)

The above quoted excerpt from the Master’s report is



DIN GREE

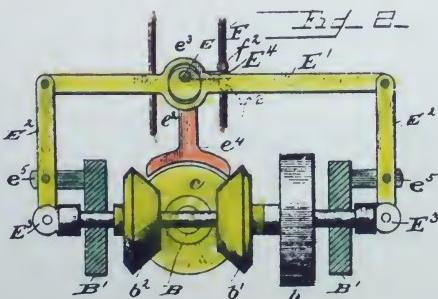
Nov. 5, 1889

414,380

A lumber carrier comprising

- (a) a FRAME,
- (b) LOAD LIFTING MEANS mounted therein,
- (c) MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction,
- (d) MEANS FOR MANUALLY MOVING THE CLUTCH to operative position,
- (e) AUTOMATIC MEANS FOR MOVING THE CLUTCH to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and
- (f) MEANS FOR BRAKING the transmitting means whenever the clutch is moved to neutral position.

(NOTE: The above is Gerlinger's Claim 4 in suit)



amply supported by the record, *e. g.*, by the succinct answer of Mr. Grab appearing at Tr. p. 582, reading as follows:

"A. The load-controlled stop proved very inefficient. We wrecked the lifting mechanism whenever no load was in the machine or if the load was of such shape and size so as to fail to strike the load-controlled stop before the load-lifting means reached its upper limits."

And such last quoted excerpt from the Master's report apparently is affirmed by appellant's counsel when, in speaking of the only Gerlinger machine ever constructed in accordance with the patent in suit, he says:

"But this construction was not found practical."
(Appellant's Brief, p. 9.)

The Dingee Patent No. 414,380 (Ex. Bk. p. 1104) Completely Negatives Invention in the Truck-and-Elevator Aggregation Recited by Gerlinger's Claim in Suit.

While the Dingee patent does not purport to show a truck carried elevator, it does establish conclusively that each and every element recited by the claim in suit has, for decades, been well known to builders of elevators.

Incidentally, there is in evidence an operative model, defendants' Ex. 61, which operates in accordance with the teachings of the Dingee patent. When such model was offered in evidence, its several elements were colored in accordance with the color scheme which characterizes the several charts included in this brief (Tr. pp. 627-631).

Appearing opposite this page is a chart corresponding to Defendants' Ex. 60. It presents Figs. 1 and 2 of the Dingee patent in convenient juxtaposition to a break-down of the Gerlinger claim in suit.

With the aid of the chart color scheme, your Honors readily will perceive that the elevator of Dingee exhibits, completely and perfectly, each and every element of the claim in suit.

For a detailed discussion of this Dingee elevator, see the testimony of Mr. Grab appearing at Tr. pp. 622-627.

The trial judge made the following amply supported finding pertinent to the Dingee patent and the elevator disclosed thereby:

“9. That in the prior art the patent to Dingee, No. 414,380, issued November 5, 1889, for Elevator, discloses a manually operated clutch by which power may be transmitted to the hoisting mechanism, and when power is thus applied, upward or downward movement is communicated to the load lifting means. Upon movement of the load lifting means to a pre-determined extent in either direction, a projection on the lift engages a stop on the cable by which the clutch is automatically operated to cause the cable to move the clutch into neutral position and to simultaneously apply the brake.” (Findings of Fact, Tr. p. 148.)

This last quoted finding of the trial judge followed some preliminary findings also very pertinent to the Dingee patent, reading as follows:

“6. That the field in which the Gerlinger invention was developed is divided into two parts, namely, that relating to *elevators* or lifting devices, and that relating to self-propelled *vehicles* or carrying devices; *that except as they are disposed on or within the same frame they are entirely independent and the essential function of each respective mechanism remains unchanged*; that the union upon one frame is mechanical; that the gearing of the respective devices to one power source is convenient, but functionally incidental; that when so united and mounted together, the truck performs no new function, but merely carries the load and moves forward and backward. Neither does the elevator perform any new function, but merely lifts or lowers the load as desired; that the peculiar qualities of a truck and of an elevator were not amalgamated to produce any new or different function or result.

7. That the essential elements of claim 4 of the patent in suit relate to the operation of a lifting device; *that in view of the prior art* relating to the con-

May 18, 1920.

Fig. 1

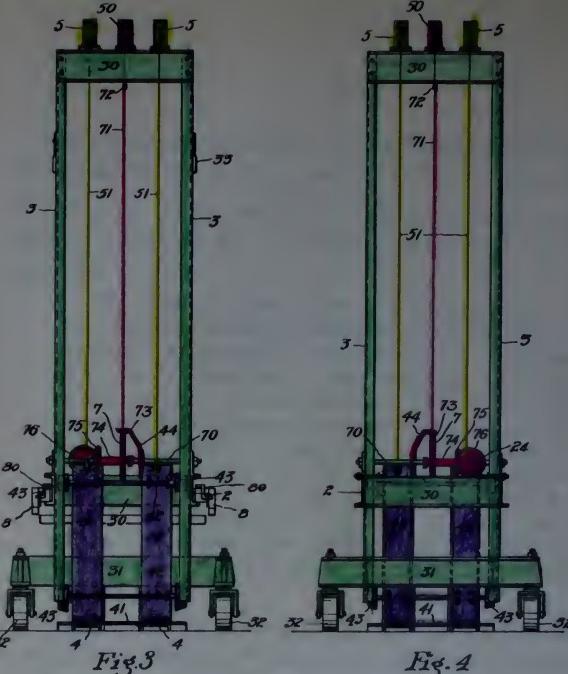
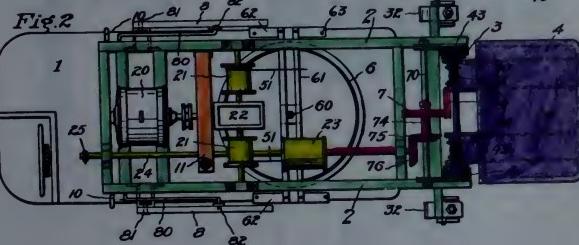
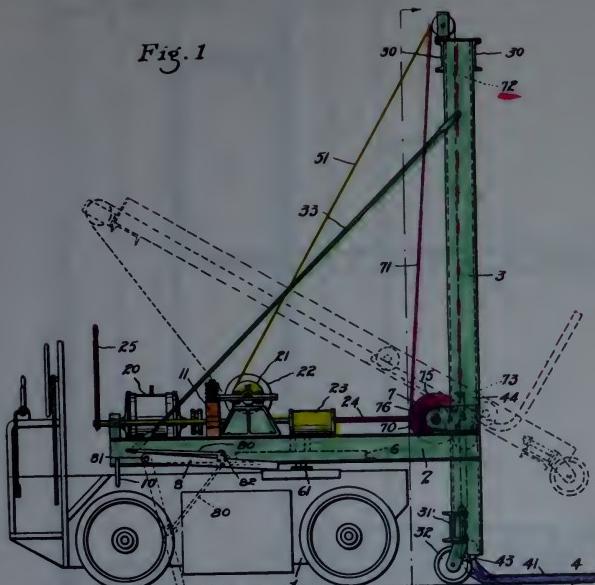


Fig. 3

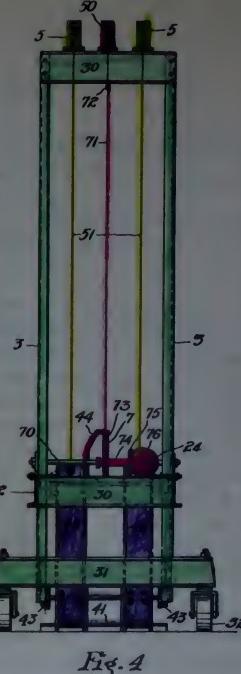


Fig. 4

A lumber carrier comprising

- a FRAME,
- LOAD LIFTING MEANS mounted therein,
- MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction,
- MEANS FOR MANUALLY MOVING THE CLUTCH to operative position,
- AUTOMATIC MEANS FOR MOVING THE CLUTCH to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and
- MEANS FOR BRAKING the transmitting means whenever the clutch is moved to neutral position.

(NOTE: The above is Gerlinger's Claim 4 in suit)

struction of elevators *every element in the Gerlinger device was old in that art, except the load actuated bar 67 which stopped the operation of the elevator by the upward pressure of the load; * * *.*.*" (Findings of Fact, Tr. pp. 147, 148.)

Thus it clearly appears that the trial court was required (a) to hold that the Gerlinger claim in suit is *totally invalid* because claiming nothing more than the use of Dingee's elevator (for its old material elevating and lowering purpose) on a lumber truck, or (b) to read into the claim the load actuated bar 67, which Dingee did not disclose and which no one (except Gerlinger in his first and only machine constructed in accordance with the patent) *ever used*.

The Nicholson Patent No. 1,340,458 (Ex. Bk. p. 1114) Also Completely Negatives Invention in the Truck-and-Elevator Aggregation Recited by Gerlinger's Claim in Suit.

Appearing opposite this page is a chart corresponding with Defendants' Ex. 63. It presents Figs. 1 to 4 inclusive of the Nicholson patent in convenient juxtaposition to a break-down of the Gerlinger claim in suit.

With the aid of the chart color scheme, your Honors readily will perceive that the truck-and-elevator machine of Nicholson, which is well adapted to carry lumber as anything else, exhibits, completely and perfectly, each and every element of the claim in suit.

For a detailed discussion of this Nicholson machine, see the testimony of Mr. Grab appearing at Tr. pp. 632-634.

With respect to this Nicholson patent the trial judge has adopted a thoroughly justified and conclusive finding, as follows:

"11. That in the prior art the patent to Nicholson *et al.*, No. 1,340,458, issued May 18, 1920, for

Portable Freight Stacking Elevator, discloses a front end carrier with a frame having load lifting means mounted therein, means for transmitting motion from a source of power to the lifting means, and a clutch that can be operated manually, set in neutral or so as to cause the load lifting means to move in either direction. The machine is equipped with automatic means for moving the clutch to neutral position upon movement of the load lifting means to a predetermined extent in either direction, and means for simultaneously applying a brake whenever the clutch is moved into neutral position. *The only material difference in structure between that shown in Letters Patent No. 1,457,025, and the Nicholson machine is that in the latter the frame containing the load lifting means is at the front end of the carrier, whereas, in the patent in suit the load lifting means is mounted between the wheels.*" (Findings of Fact, Tr. p. 149.)

The Nicholson truck-and-elevator machine, like the accused device presently to be described, does lack the *load actuated* member 67 which gives the machine of the patent its peculiar (and unsatisfactory) mode of operation.

With the Nicholson patent before him, the trial judge obviously had but two choices. He was required to hold the claim in suit invalid in view of Nicholson, or, *alternatively*, to limit the claim to the load actuated limit stop member 67 which neither Nicholson, nor any of the other prior art structures, nor the accused machine, includes.

**The French et al. Patent No. 1,360,917 (Ex. Bk. p. 1122)
Is Another Item in the Prior Art Which Completely
Negatives Invention in the Truck-and-Elevator Aggre-
gation Recited by the Gerlinger Claim in Suit.**

Appearing opposite this page is a chart corresponding with Defendants' Ex. 65. It presents Figs. 1, 2, and 3 of the French *et al.* patent in handy juxtaposition to a break-down of the Gerlinger claim in suit.

1,360,917.

Nov. 30, 1920.

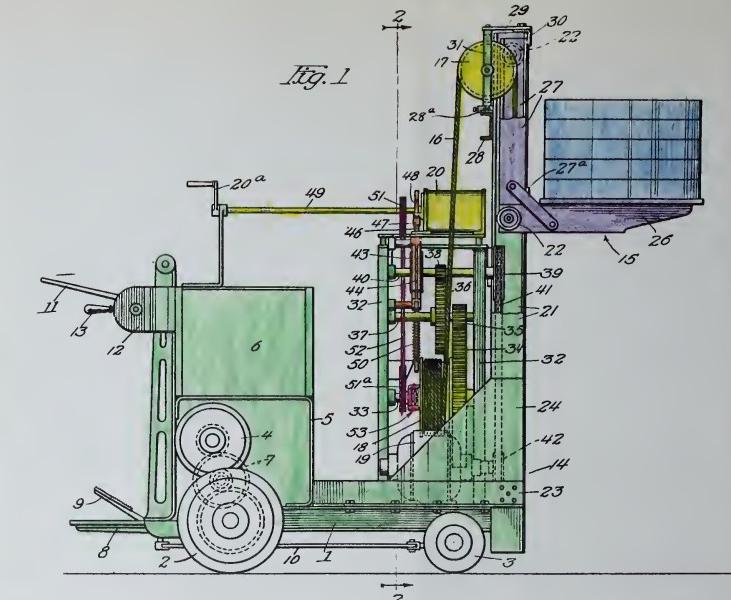
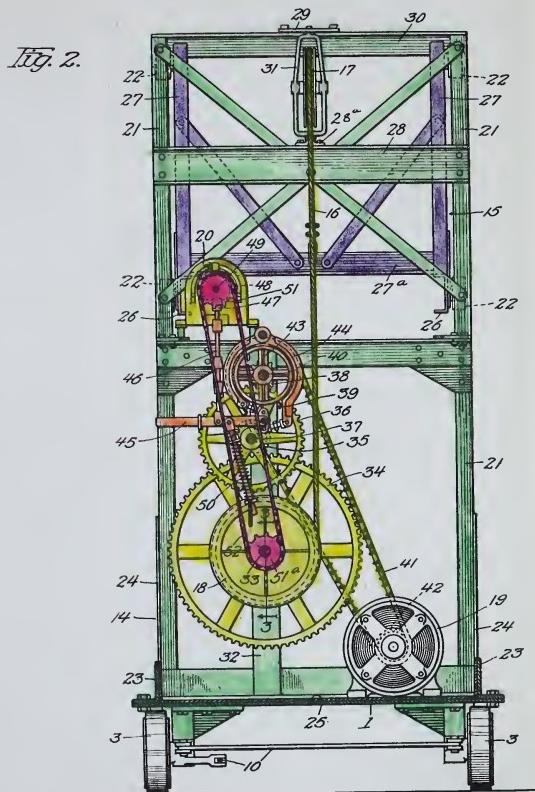
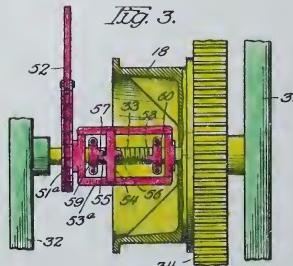


Fig. 3



- A lumber carrier comprising

 - (a) a FRAME,
 - (b) LOAD LIFTING MEANS mounted therein,
 - (c) MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction,
 - (d) MEANS FOR MANUALLY MOVING THE CLUTCH to operative position,
 - (e) AUTOMATIC MEANS FOR MOVING THE CLUTCH to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and
 - (f) MEANS FOR BRAKING the transmitting means whenever the clutch is moved to neutral position.

With the aid of the chart color scheme your Honors will have no difficulty in perceiving that the truck-and-elevator machine of French *et al.* presents, completely and perfectly, each and every element of the claim in suit. Obviously, this French *et al.* machine is as well adapted to carry lumber as anything else.

For a detailed discussion of this French *et al.* machine see the testimony of Mr. Grab appearing at Tr. pp. 644-656.

In one respect this French *et al.* patent is peculiarly interesting in this case. Its elevator limit stop mechanism corresponds almost exactly with the limit stop mechanism incorporated in the elevator of the accused machine.

With respect to this French *et al.* patent the trial judge adopted a well grounded finding, as follows:

"12. That in the prior art the patent to French *et al.*, No. 1,360,917 issued November 30, 1920, for Elevating and Conveying Apparatus, discloses the combination with a truck of a load lifting means mounted in a frame on the front end of the truck. The stop which actuates the clutch and throws it into neutral and causes the brake to be applied consists of a traveling nut on a threaded main shaft which engages lugs or collars which operate, by appropriate connection, to throw the clutch into neutral and apply the brake. *The operation is similar to that adopted by the defendants.*" (Findings of Fact, pp. 149, 150.)

With the French *et al.* patent before him, the trial judge had but two courses open to him. He could hold the claim in suit clearly invalid in view of the prior art as exhibited by French *et al.* Alternatively, he could read into the claim a limitation to the load actuated limit stop member 67 which nothing in the prior art exhibits, and which the accused machine does not include. Assuredly appellant has no real cause to complain in that the trial judge held the claim in suit limited to the patentee's exact disclosure, and as thus limited *valid*, instead of invalidating it.

**The Towson et al. Patent No. 1,337,804 (Ex. Bk. p. 1130)
Is Another Prior Art Disclosure Which Completely
Negatives Invention in the Truck-and-Elevator Aggre-
gation Called For by the Gerlinger Claim in Suit.**

Appearing opposite this page is a chart corresponding with Defendants' Ex. 67. It presents Figs. 1, 5, and 6 of the Towson *et al.* patent drawings alongside of a breakdown of the Gerlinger claim in suit.

Aided by the chart color scheme, your Honors will perceive that the truck-and-elevator machine of Towson, *et al.* presents a full and satisfactory response to each and every element specified by the claim in suit.

For a detailed discussion of this Towson *et al.* machine see the testimony of Mr. Grab appearing at Tr. pp. 656-665.

In this Towson *et al.* machine the reversible friction clutch of the Gerlinger patent drawings finds its full, and unquestionable, equivalent in the reversing switch for the electric motor which Towson *et al.* chose to employ as their power source. Also, in this Towson *et al.* machine, the friction brake (of doubtful construction and dubious mode of operation) which the Gerlinger patent attempts to illustrate, finds its full, and unquestionable, equivalent in a magnetic brake functioning when the Gerlinger brake is said to function, and accomplishing precisely the same result which the Gerlinger brake is said to accomplish.

In connection with this Towson *et al.* patent the trial judge made the following fact finding:

"10. That in the prior art the patent to Towson *et al.*, No. 1,337,804, issued April 20, 1920, for Industrial Truck, discloses a self-propelled industrial truck having a load lifting means mounted in the front end thereof, and disclosing automatic means for disconnecting the source of power from the hoisting mechanism and simultaneously applying the brake. Inas-

Fig. 1

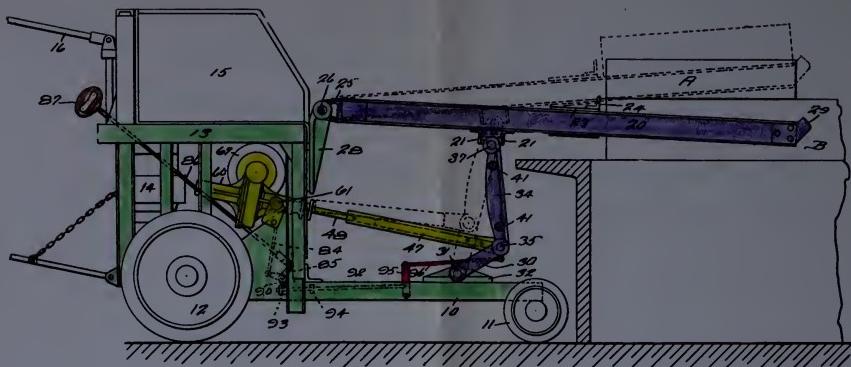


Fig. 5

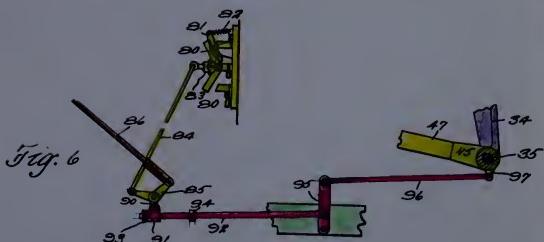
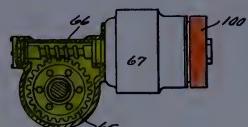


Fig. 6

- A lumber carrier comprising
- FRAME,
 - LOAD LIFTING MEANS mounted therein,
 - MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction,
 - MEANS FOR MANUALLY MOVING THE CLUTCH to operative position,
 - AUTOMATIC MEANS FOR MOVING THE CLUTCH to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and
 - MEANS FOR BRAKING the transmitting means whenever the clutch is moved to neutral position.

(NOTE: The above is Gerlinger's Claim 4 in suit)

much as the truck is electrically operated, the automatic stop operates to break an electrical contact and thereby disconnect the source of power from the hoisting mechanism.” (Tr. p. 148.)

The Carr Patent No. 1,407,124 (Ex. Bk. p. 1152) Exhibits Another Prior Art Carrier Which Completely Negatives Invention in the Truck-and-Elevator Aggregation Specified by the Gerlinger Claim in Suit.

Appearing opposite the next following page is a chart corresponding with Defendants' Ex. 70. It presents Figs. 1 and 8 of the Carr patent drawings in juxtaposition to a break-down of the Gerlinger claim in suit.

With the aid of the chart color scheme your Honors readily will perceive that the truck-and-elevator carrier of Carr is a full and complete response to the recitals of the claim in suit.

For a detailed discussion of this Carr carrier, see the testimony of Mr. Grab appearing at Tr. pp. 666-671.

This Carr carrier does not comprise a clutch, in the limited sense of that term, but it does present the full equivalent of the reversing clutch of Gerlinger in that it comprises circuit breaking mechanism which connects or disconnects the source of power with and from the load lifting mechanism.

Of this Carr carrier the trial judge has said:

“13. That in the prior art the patent to Carr, No. 1,407,124, issued February 21, 1922, for Elevator Truck, discloses a self-propelled electrically operated elevator truck with a front end lift. The device does not employ a clutch, but means for making or breaking the electrical circuit connects or disconnects the source of power from the load lifting mechanism. It has an automatic brake and by virtue of certain stops the power is disconnected and the brake applied automatically at predetermined upper and lower limits of travel.” (Findings of Fact, Tr. p. 150.)

Carr, like the other prior art structures, and like the accused machine, lacks anything corresponding to the load actuated bar 67 of the patent in suit. But it is, in all respects, a substantive response to the claim in suit. If the bar 67 is not read into claim 4, then such claim is clearly and hopelessly invalid.

The Grab Patent Drawing Inserted Between Pages 22 and 23 of Appellant's Brief Does Not Represent the Accused Machine.

At the very beginning of his discussion headed "The Facts as to Infringement" opposing counsel inserts a copy of the drawing of Grab Patent No. 1,838,939 resulting from an original application filed July 23, 1927.

Such Grab patent has no place in a purported discussion of the alleged infringement of the patent in suit by the accused machine of defendants-appellees.

Such Grab patent drawing exhibits a purely *experimental machine* dated more than eight years before the filing of this suit. It differs radically, in structure and mode of operation, from the accused machine as made and sold by Willamette-Hyster Company and as used by Clark & Wilson Lumber Company.

Such early experimental machine depicted in the Grab patent was unsuccessful from an operating standpoint—because it comprised a bar 79 corresponding generally with the bail-like bar 67 which gives the machine of the patent in suit its peculiar, self-destructive, and intolerable mode of operation.

As to this experimental machine, differing as it does so radically from the accused machine, Mr. Grab testified as follows:

"Q. (By Mr. Fryer): You are the G. A. Grab on whose application patent 1838939 issued?

1,407.124.

Feb. 21, 1922.

GARR

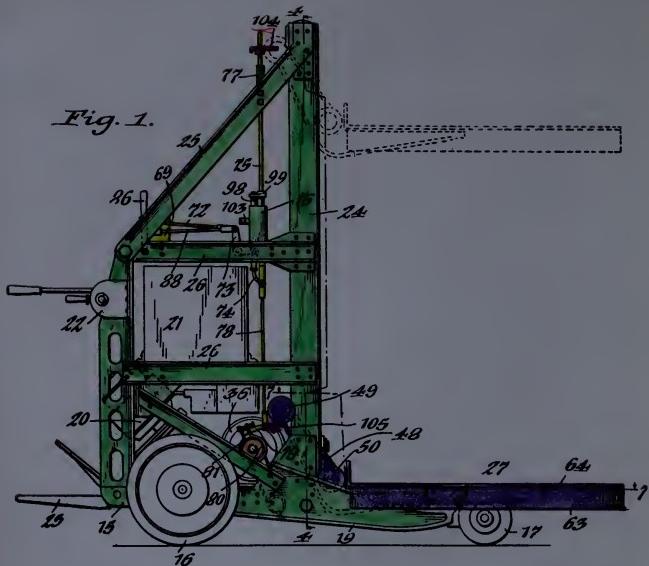
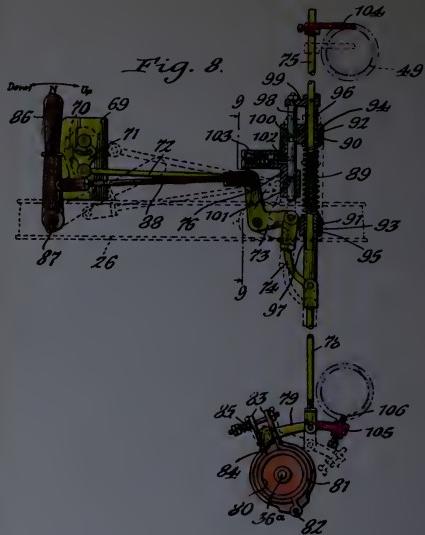


Fig. 1.



A lumber carrier comprising

- (a) a FRAME,
 - (b) LOAD LIFTING MEANS mounted therein,
 - (c) MEANS FOR TRANSMITTING MOTION FROM A SOURCE OF POWER TO THE LOAD LIFTING MEANS comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction,
 - (d) MEANS FOR MANUALLY MOVING THE CLUTCH to operative position,
 - (e) AUTOMATIC MEANS FOR MOVING THE CLUTCH to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and
 - (f) MEANS FOR BRAKING the transmitting means whenever the clutch is moved to neutral position.

(NOTE: The above is Gerlinger's Claim 4 in suit)

A. Yes.

Q. Will you state whether or not you ever built a machine having part 79 of that patent in it as shown on the chart Exhibit 48?

A. Yes, only *experimentally*.

Q. Will you state whether or not that mechanism like the bar 79 and connected instrumentalities was *successful* from an operating standpoint?

A. No, it was not.

Q. Will you state whether or not the defendant Willamette-Hyster Company at any time within six years prior to the bringing of this suit made or sold a machine containing in it a part having the construction or operation of the part 79 on Exhibit 48?

A. No, it has not.

Q. In other words, that member in that machine on Exhibit 48 which was designed to be engaged by the load in certain operations *was never put into practical or commercial use by defendant Willamette-Hyster Company within six years prior to the filing of this suit, is that right?*

A. That is right." (Tr. p. 682.)

Clearly the Grab patent drawing can serve no purpose, other than to becloud and confuse the issue, when the question of alleged infringement is being considered.

The Accused Machine Follows the Teachings of the Prior Art. Its Elevator Cannot Operate as Does the Elevator of the Gerlinger Patent in Suit.

The documentary exhibits, *actually* illustrative of the accused machine, which have been referred to in the brief of opposing counsel, are:

The Photo—Plaintiff's Exhibit 35—Ex. Bk. p. 941.

The Photo—Defendants' Exhibit 56-a—Ex. Bk. p. 1011.

The Photo—Defendants' Exhibit 56-b—Ex. Bk. p. 1012.

The Enlarged Manual Drawing No. 2—Plaintiff's Exhibit 34—Ex. Bk. p. 940-A.

Incidentally, the photo Exhibit 56-b, being one of de-

fendants' exhibits, has been colored in accordance with the same plan as were defendants' charts heretofore discussed in this brief. The coloring carried by the manual enlargement, Plaintiff's Exhibit 34, was *not* applied in accordance with such plan.

The accused machine is very different, in both construction and mode of operation, from the machine of the Gerlinger patent in suit. Nevertheless, it responds to the broad and comprehensive language of the claim in suit in exactly the same way as do the prior art machines discussed at earlier points in this brief.

By referring to the photo Defendants' Exhibit 56-a, your Honors will note that the accused machine is of inverted U-shape in transverse section. In other words, it has the inverted U-shape, in transverse section, which has always characterized these so-called "straddle trucks." See for example Fig. 4 of the Ross patent No. 1,209,209, applied for May 11, 1914, granted December 19, 1916 (Ex. Bk. p. 1206).

Referring again to the photo Defendants' Exhibit 56-b, it will be seen that the accused machine does comprise a green colored frame—the usual straddle truck frame.

And, referring to the same photo, it will be seen that the elevator of the accused machine comprises purple colored load lifting mechanism. This load lifting mechanism includes bell cranks. One only of these bell cranks is shown in the photo Defendants' Exhibit 56-b, and the enlarged manual drawing, Plaintiff's Exhibit 34. But in the photo Plaintiff's Exhibit 35, two are shown. There are two on each side of the machine. Depending from the long arm of each bell crank is a "lifting rod," one of which is so labeled in the photo, Plaintiff's Exhibit 35. The lower ends of the lifting rods, on each side of the machine, are connected by a horizontally disposed grappling bar. These

grappling bars are in the nature of angle irons. The short arm of each bell crank is connected with a nut which travels back and forth on a screw shaft forming part of the motion transmitting mechanism presently to be described. In the photo, Defendants' Exhibit 56-b, the nut is colored purple and the screw shaft with which it co-operates is colored yellow.

Thus, so far as mechanical instrumentalities are concerned, the load lifting mechanism of the accused device differs in almost every conceivable respect from the load lifting mechanism of the Gerlinger patent. Whereas the Gerlinger patent comprises rack bars provided at their lower ends with trick shoes 59 (see Fig. 3 of patent in suit) the lower ends of the lifting rods, in the case of the accused machine, are connected with horizontally disposed grappling bars substantially identical with the grappling bars 42 of the old Ross patent No. 1,209,209 (Ex. Bk. p. 1206). And whereas the rack bars of Gerlinger are driven through spur gearing, the lifting rods of the accused machine are actuated by the bell crank, link and nut mechanism to which we have alluded—such parts being colored blue on the photo, Defendants' Exhibit 56-b.

In the accused machine the means for transmitting motion from the source of power to the load lifting means comprises shafts, rods, sprocket wheel and chain, etc., colored yellow in Defendants' Exhibit 56-b. This motion transmitting means of the accused device, has little in common with the corresponding mechanism of the Gerlinger patent in suit, except in that both are old and well known mechanisms and both are constructed and operate in accordance with well known mechanical principles, to perform the old and well known power transmitting function in a truck carried elevator. Such power transmitting means of the accused device does comprise a clutch which,

like the corresponding clutches of the truck carried elevators of the prior art, has a "neutral" position, a "hoisting" position, and a "lowering" position.

In the accused device the usual lever for manipulating the hoist to its several positions is located near the truck steering wheel. It appears in brown at the upper left hand side of the photo, Defendants' Exhibit 56-b.

And the accused device, like the several prior art structures hereinbefore discussed, is provided with automatic means for moving the clutch to neutral position upon movement of the load lifting means to a *predetermined extent in either direction*. Like the devices of the prior art, such "automatic means for moving the clutch" is colored in red on the photo, Defendants' Exhibit 56-b. Its more important parts happen to be colored yellow on the manual drawing enlargement, Plaintiff's Exhibit 34. Incidentally, this "automatic means for moving the clutch", is nothing more nor less than an ordinary limit stop mechanism which has been used for scores of years on elevators, lathes, and other devices to limit the movement, in each direction, of a driven part which moves to and fro, either continuously or intermittently, in the operation of the machine. Your Honors have seen many varieties of this limit stop mechanism in the truck carried elevators of the prior art here presented. There are probably no gadgets, in the whole realm of practical mechanics, which are better known to the every-day-garden-variety of mechanic than are limit stops to throw clutches, to stop movement, or to reverse movement, as may be necessary, in machines of all kinds.

The photo, Defendants' Exhibit 56-b, shows the limit stop mechanism, as well as a photo can, just as it appears in the accused machine. Plaintiff's Exhibit 34, shows the same limit stop mechanism more or less diagrammatically. Let us refer to the latter for a moment.

Referring to Plaintiff's Exhibit 34: When the carrier elevator is lowering its load the screw (2) is so turning as to cause the traveling nut to move to the left. Carried by the traveling nut is a member EB comprising an eye receiving and traveling on the reciprocatory rod GB. When the elevator mechanism is operated sufficiently in the downward direction, the member EB engages the right hand one of the limit stops LS to cause bodily movement of rod GB to the right. Thereupon said rod GB, acting through the mechanism connected therewith, throws the clutch to neutral and returns the manually operated lever (HL) to neutral. It will be understood that there are four of the traveling nuts, each linked to an appropriate bell crank, but that only one of said nuts need carry a member EB forming part of the limit stop mechanism.

And on the upward movement of the elevator, the operation of the limit stop mechanism is as follows:

The screw (2) is so turning as to cause the traveling nut to move toward the left. When the elevator mechanism is moved to its predetermined upward limit, the nut carried member EB engages the left hand one of the limit stop members LS bodily to move the rod GB to the left. Rod GB then acts through its connected mechanism to throw the clutch to neutral and, of course, to return the hand lever HL to its neutral position.

The limit stop mechanism of the accused device, therefore, is like the limit stop mechanisms of the prior art machines previously discussed in this brief, in that it acts effectively to move the clutch to neutral position, when the load lifting means of the elevator has moved to a predetermined extent in the upward direction **REGARDLESS** of whether or not there is a load in the elevator and **REGARDLESS** of whether or not that load is a large one or a small one.

Therefore, the operating law of the accused machine is the same law which governs the operation of the prior art machines previously discussed in this brief. That law is that the clutch shall be thrown to neutral when the load lifting means has moved to a predetermined extent, in the upward direction quite independently of any load, and REGARDLESS of whether there be any load in the machine, and REGARDLESS of the size of that load if there be any such.

The machine of the Gerlinger patent in suit, on the other hand, operates according to a different law. On the upward movement of the elevator it throws out the clutch *only in the event* that there is a load in the elevator to do the job,—in other words, *only if* there is a load in the elevator to engage and actuate the bail-like member 67 which is the characteristic and only novel feature of the patented Gerlinger machine.

Therefore, the machine of the Gerlinger patent in suit has its own peculiar mode of operation. The structure of the accused machine is such that it has a different mode of operation, *i. e.*, the mode of operation which characterizes the machines of the prior art. The law governing the operation of the prior art machines, heretofore discussed in this brief, is that the clutch shall be thrown to neutral whenever the load lifting devices have moved to a predetermined extent in the upward direction, even if there be no load. That, also, is the law which governs the operation of the accused machine. But it is not the law which governs the operation of the patented Gerlinger machine.

The trial judge has made some definite and well supported findings with respect to the peculiar mode of operation which characterizes the machine of the Gerlinger patent in suit, and the load actuated bar 67 which is accountable for that peculiar mode of operation.

The trial judge has found that the machine of the patent in suit is one

"3. * * * having also load actuated means for automatically moving the clutch into neutral position upon movement of the load to a predetermined extent in an upward direction, said load actuated means comprising in part a pivoted bar engageable by the top of the load as it is hoisted, with suitable linkage for moving the clutch into neutral position and applying the brake; * * *". (Findings of Fact, Tr. p. 145.)

And findings 4 and 5, as made by the trial judge, read as follows:

"4. That the particular automatic means for moving the clutch to neutral position shown and described in Letters Patent No. 1,457,025 so far as limitation of upward movement is concerned, is the *pivoted bar identified by the reference character 67.*"

"5. *That the patentee and plaintiff built but one machine as shown and described in said Letters Patent No. 1,457,025, having a load actuated pivoted bar for moving the clutch into neutral position and applying the brake; that this bar was operative only when a load was present upon the load lifting means, and was inoperative when the load was not sufficiently high or was so placed or of such a character as not to engage and move said bar * * *.* (Findings of Fact, Tr. p. 146.)

The Accused Machine Is Substantially Identical With Prior Art Machines, and Therefore Cannot Infringe the Claim in Suit.

In this case it appears that the structure of the accused machine is substantially identical with the structures of prior art machines, that the accused machine operates as do the prior art machines, and that the accused machine *does not operate* as the machine of the patent in suit *must operate*.

Moreover, the evidence in this case makes it crystal clear that, in so far as the subject matter of the suit is

concerned, any mechanic, familiar with the prior art, could have built the accused machine without knowing a thing about the Gerlinger patent in suit or the very impractical machine which it monopolizes.

On this last mentioned proposition the trial judge has found:

"8. That the machines built or operated by the defendants could have been constructed by the use of ordinary mechanical skill by the use of structures disclosed and described in prior patents relating to front end carriers or elevators." (Findings of Fact, Tr. p. 148.)

It is well settled by the courts, in this and other circuits, that whenever, as in the case at bar, the accused machine is substantially identical with machines of the prior art

- (a) It cannot be the machine of the patent in suit.
- (b) It cannot amount to an appropriation of anything validly covered by the patent in suit.
- (c) It does not infringe.

"The Stafford patent, No. 860,418, for a process of effecting combustion of crude petroleum, consisting in the continuing discharge into a confined area of liquid oil, at a distance from the point of combustion, of an oxygenous fluid under pressure sufficient to effect substantially perfect combustion, held not infringed, in that defendant's process did not differ from those disclosed by patents prior to plaintiff's patent."

Stafford v. Albers Bros. Milling Co., 263 Fed. 86 (Syllabus) (C. C. A. 9).

"If the change from the Foster machine is a substantial departure from a vital element or elements of the patent in suit, or a reversion to the prior art, it cannot be said that plaintiffs' rights are invaded. The sustaining of a patent upon a differentiation from the prior art does not authorize the successful party to gather to himself a monopoly of what was old when he entered the field."

T. L. Smith Co. v. Cement Title Machinery Co.,
257 Fed. 423, 424 (C. C. A. 8).

"What is old, the public is entitled to use, and a claim couched in general terms must be restricted to such other forms and equivalents. The forms used in the prior art must be protected from inclusion. *Knapp v. Morss*, 150 U. S. 221, 14 Sup. Ct. 81, 37 L. Ed. 1059."

Oehrle et al. v. William H. Horstmann Co. (C. C. E. D. Penn.), 131 Fed. 487, 490.

"Aside from all this, however, there are several reasons why we find that there has been no infringement of any of the claims in suit under the patents that we are now considering. Some of the devices used by both the appellant and the appellees are old; hence there is no infringement."

Magnavox Co. v. Hart & Reno et al., 73 Fed. (2d) 433, 441 (C. C. A. 9).

Defendant's machines "are substantially in line with the prior art and therefore do not infringe in any particular."

Houston v. Brown Mfg. Co., 270 F. 445, 448 (C. C. A. 6).

"Nor is it infringement to use * * * something which was old, and which the public had a right to use, prior to the patentee's invention, * * *".

48 Corpus Juris, p. 293, Sec. 490.

Infringements Is Not Established by Showing That the Mere Language of the Claim Can Be Applied to the Accused Machine.

The single claim in suit is couched in broad and comprehensive terms. Indubitably its verbiage reads upon the accused machine in exactly the same way that it reads upon the prior art machines. But despite the fact that the verbiage of the claim may be applied to the accused device, the facts remain that the accused device does not include any load actuated member (like the member 67 of the Gerlinger

patent) for moving the clutch to neutral, and the accused machine, lacking such load actuated member, cannot operate as the machine of the patent in suit must operate.

The one and only thing which any patentee properly can claim as being within his monopoly is that combination disclosed in his patent which is different from any combination in the prior art. And his claim must be so construed as to cover that new thing by which he differs from the prior art, because that new thing, according to the authorities, is the only thing in which he can enjoy a property right under the patent statutes.

The following authorities are directly in point:

“We note that appellant contends that the claims of the patent in suit read upon appellees’ device. We may assume that this is true, especially as to claim 9. *But infringement is not a mere matter of words.* *Henderson v. Welch Dry Kiln Co.*, D. C. 26 F. 2d 810, 814; *Goodyear Shoe Mach. Co. v. Spaulding*, C. C., 101 F. 990, 994; *Linde Air Products Co. v. Morse Dry Dock & Repair Co.*, 2 Cir., 246 F. 834, 838; *Bird v. Elaborated Roofing Co. of Buffalo*, 2 Cir., 256 F. 366, 373. Here, we hold that the mode of operation is different and that there is no equivalency of means. It is not necessary to discuss the claims separately or in detail. We agree with the finding of the trial court that there is no infringement.

“Decree affirmed.”

Grant v. Koppl, 99 Fed. (2d) 106, 110 (C. C. A. 9, September 16, 1938—Wilbur, C. J.).

“Appellant cites, as evidence of infringement, the testimony of his expert witness, George J. Henry, to the effect that some of the claims in suit read upon appellee’s machine. This, appellant contends, was sufficient to require submission of the case to the jury. The contention is rejected. *Infringement is not proved merely by reading a claim upon an accused device.* *For infringement is not a mere matter of words.* *Grant v. Koppl*, 9 Cir., 99 F. 2d 106, 110. The evidence shows conclusively that, properly construed, the claims in suit were not infringed by appellee. That being so, it

is immaterial—if true—that some of the claims read upon appellee's machine.”

McRoskey v. Braun Mattress Co., 107 Fed. (2d) 143, 147 (C. C. A. 9—Nov. 3, 1939—Mathews, C. J.).

“An abundance of authority sustains the point that a defendant's device may be within the language of a claim and not be an infringement; that an infringement is not a mere matter of words. *General Electric Co. v. Allis-Chalmers Co.*, 178 F. 273, 276 (C. C. A. 3) *Id.* (C. C.) 171 F. 666, 669, citing *Westinghouse v. Boyden*, 170 U. S. 537, 18 S. Ct. 707, 42 L. Ed. 1136.”

Henderson et al. v. Welch Dry Kiln Co. Inc., 26 Fed. (2d) 810, 814 (Affirmed 39 Fed. (2d) 589 C. C. A. 5)).

“Conceding that the claims in suit may be read on the mechanism of the defendant's machines, it is now well settled that this is not enough to establish infringement. ‘It must be determined that the device of the defendant is not merely in words but in fact the invention of the patent.’ *Elevator Supplies Co. v. Graham & Norton Co.* 44 F. (2d) 354, 355 (C. C. A. 3); *Westinghouse v. Boyden Power-Brake Co.*, 170 U. S. 537, 568, 569, 18 S. Ct. 707, 42 L. Ed. 1136.”

Complete Calculator Co. v. Monroe Calculating Mach. Co. 4 Fed. Supp. 842, 847.

“‘Infringement should not be determined by a mere decision that the terms of a claim of a valid patent are applicable to the defendant's device. Two things are not precisely similar because the same words are applicable to each. The question of infringement involves considerations of practical utility and of substantial identity, and therefore must be quantitative as well as qualitative.’ *Goodyear Shoe Mach. Co. v. Spalding* (C. C.) 101 Fed. 990. We conclude, therefore, that defendant's biograph camera does not infringe claims 1, 2 or 3 of the reissue.”

Edison v. American Mutoscope & Biograph Co., 151 Fed. 767, 773, 774 (C. C. A. 2).

See also:

Silver & Co., Inc. v. S. Sternau & Co., Inc., 258 Fed. 448, 451 (C. C. A. 2).

Cadwell v. Firestone Tire & Rubber Co. 13 Fed. (2d) 483, 487. Affirmed 23 Fed. (2d) 1000 (C. C. A. 2).

The Accused Machine Has a Substantially Different Mode of Operation from That of the Patent in Suit, and Therefore Does Not Infringe.

It is well settled by decisions of the Supreme Court, and of this Circuit and other Circuits, that a claim for a machine characterized by one definite mode of operation cannot be infringed by a machine for a different mode of operation.

In the machine of Gerlinger's patent, the clutch *may be* moved to neutral during the upward movement of the load lifting means, by engagement of a load with the load actuated stop member (67). If there is no load, or if the load is of such size or so located that it cannot be engaged by the load actuated member, there is no movement of the clutch to neutral.

In the accused machine the clutch *always* is moved to neutral at a predetermined point in the upward movement of the load lifting means, *independently* of any load and *regardless* of whether there be any load in the load lifting means. The accused machine does not embody any load actuated stop member because its mode of operation, being different from that of Gerlinger's patent, does not require any such instrumentality.

While the verbiage of the claim in suit may be broad and comprehensive enough—vague enough—to describe the accused machine, there is still no infringement. This is so because the mode of operation of the accused machine is not the mode of operation of Gerlinger's patented machine.

"The patentee may bring the defendant within the letter of his claims, but if the latter has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent his actual invention, he is as little subject to be adjudged an infringer as one who has violated the letter of a statute has to be convicted, when he has done nothing in conflict with its spirit and intent. 'An infringement,' says Mr. Justice Grier in *Burr v. Duryee*, 1 Wall. 531, 572, 'involves substantial identity, whether that identity be described by the terms, "same principle," same "modus operandi," or any other.' "

Westinghouse v. Boyden Power Brake Company,
170 U. S. 537, 568 (Certiorari to C. C. A. 4).

" 'If the device of the respondents shows a substantially different mode of operation, even though the result of the operation of the machine remains the same, infringement is avoided.' *Cimiotti Unhairing Co. v. American Fur Ref. Co.*, 198 U. S. 399, 414, 25 Sup. Ct. 697, 702 (49 L. ed. 1100).'"

Riverside Heights Orange Growers' Ass'n. et al. v. Stebler, 240 Fed. 703, 710 (C. C. A. 9).

"Plaintiff attempts to show infringement by the defendant by trying to literally read claims 9, 10, 11, and 15 on the defendant's structure, but this does not seem to me to be the proper test in the suit at bar, because even though the plaintiff could bring the defendant within the letter of the claims of the patent in suit, the defendant could not be adjudged an infringer if it has so far changed the principle of the device that the claims of the patent, literally construed, have ceased to represent the actual invention of the patent in suit. *Westinghouse v. Boyden Power Brake Co.*, 170 U. S. 537, 568, 18 S. Ct. 707, 42 L. Ed. 1136."

Cadwell et al. v. Firestone Tire & Rubber Co., 13 Fed. (2d) 483, 487 (Affirmed, 23 Fed. (2d) 1000 (C. C. A. 2)).

**It Is the Duty of the Court to so Construe the Language
of the Claim That It Will Not Describe or Include Any
Prior Art Structure. (When So Construed the Claim
Does Not Describe the Accused Machine.)**

We have shown your Honors that Gerlinger's claim in suit meets a complete response in each of several patents of the prior art,—also that the claim, as it appears in the patent in suit, defines nothing of an inventive character over or beyond what was old and well known in the prior art. Thus we have demonstrated the soundness of that conclusion of the trial court which reads as follows:

"2. That the invention defined by claim 4 of the patent in suit was not novel or patentable at the time of the alleged invention thereof by Carl F. Gerlinger, and that the subject matter of said claim and all material and substantial parts thereof had been known, used, invented and described and published in and by the following United States Letters Patent prior to the alleged invention or discovery thereof by the said Carl F. Gerlinger and for more than two years prior to the date of filing of the application for said patent:

Dingee	414,380	Nov.	5, 1889
Towson, <i>et al.</i>	1,337,804	Apr.	20, 1920
Nicholson, <i>et al.</i>	1,340,458	May	18, 1920
French, <i>et al.</i>	1,360,917	Nov.	30, 1920
Carr	1,407,124	Feb.	21, 1922."

(Tr. pp. 156, 157.)

On the basis of the foregoing conclusion, which undoubtedly is a correct and amply supported one, the trial court would have been justified in adjudging the single claim in suit to be wholly and hopelessly invalid.

But the facts in this case, and the authorities, afford ample justification for holding the claim in suit very narrowly valid,—valid only when limited to the particular machine disclosed and described in the patent, *i. e.*, that

particular machine which comprises *inter alia* the load actuated stop member 67.

On the basis of the facts of record, the trial judge found:

“7. That the essential elements of claim 4 of the patent in suit relate to the operation of a lifting device; *that in view of the prior art relating to the construction of elevators every element in the Gerlinger device was old in that art, except the load actuated bar 67 which stopped the operation of the elevator by the upward pressure of the load; * * *.*” (Findings of Fact, Tr. pp. 147, 148.)

And the trial judge also found:

“14. That in no one of the prior art patents is there shown or described automatic means for moving the clutch to neutral position *which is dependent upon the presence of a load upon the load lifting means, and that only in this respect, i. e., the load actuated factor, does the means shown and described in Letters Patent No. 1,457,025 differ from the disclosures of the prior art.*” (Findings of Fact, Tr. p. 150.)

And the trial judge also found:

“18. That that which was in fact the invention of the patentee Carl F. Gerlinger was an automatic stop *actuated by the load itself in upward movement, and an automatic stop controlling the downward movement of the kind and character shown by his drawings and specification.*” (Findings of Fact, Tr. p. 152.)

The above quoted findings amply are supported and justified by the evidence. Consequently, the trial judge was forced to the conclusion that the claim in suit

“to be construed as valid, must be restricted to the particular form of device disclosed and described in the drawings and specification of the Gerlinger patent.” (4th Conclusion of Trial Judge, Tr. p. 157.)

This means, of course, that the claim must be limited and restricted to the one thing which Gerlinger had con-

tributed to the art (although it was of practically no value), *i. e.*, the *load actuated* device for moving the clutch.

That the trial judge was justified in thus limiting and restricting the claim in suit in order to save it from total invalidity, is shown by the following authorities:

"It is unnecessary to do more than refer to the proposition that the claims must be so interpreted as to give them a valid meaning, if possible, and that, if they would be rendered invalid by an interpretation so broad as to cover the defendant's structure, it is to be presumed that the plaintiff, in using the language which he put in the claims and which was allowed by the Patent Office, was describing that which can be held patentable; in other words, that the claims must be limited to the patentable invention, even though reference to the specifications, drawings, and prior art is had, in order to learn the limitations referred to."

F. N. Burt Co., Limited v. W. C. Ritchie & Co.,
251 Fed. 909, 913.

"While it is true that courts will not ordinarily interpret a positively recited generic expression as limited to the precise instrumentality disclosed by the patent, they will do even this where such narrow interpretation is necessary to distinguish the claim from the prior art and uphold the validity of the claim. *International Banding Mach. Co. v. American Bander Co.*, 9 Fed. (2) 606, 608 (C. C. A. 2)."

Black & Decker Mfg. Co., et al. v. Baltimore Truck Tire Service Corporation, 40 Fed. (2d) 910, 914 (C. C. A. 4).

"And, where necessary to uphold the validity of the patent, the court will construe even positive generic expressions as limited to the precise instrumentality disclosed by the patent. *Black & Decker Mfg. Co. v. Baltimore Truck Tire Service Corporation* (C. C. A. 4th) 40 F. (2d) 910. When the claims of the Tomlinson patent are limited to the mechanism de-

scribed in the specification and drawings of that patent, they are clearly not infringed by the machines of defendants."

Demco, Inc., et al. v. Doughnut Mach. Corporation. *Joe-Lowe Corporation, et al. v. Same,* 62 F. (2d) 23, 25 (C. C. A. 4).

"It is the duty of the court to read a claim in the light of the entire disclosure of the patent as a whole. It will interpret an expression positively recited in the claim as satisfied by any suitable instrumentality capable of performing the stated function successfully, unless, by so doing, violence to some other patent may be committed. It should never interpret a positively recited generic expression as limited to the precise instrumentality disclosed by the patent, except where such narrow interpretation is necessary to distinguish the claim from the prior art. In such cases, the courts will always do so in order to uphold the validity of the claim where that is possible."

International Banding Mach. Co. v. American Bander Co., Inc., 9 Fed. (2d) 606, 608 (C. C. A. 2).

"It seems quite clear that the idea of a protected casing for a pump shaft without restrictive interpretation would contain no novelty and would not be patentable, and, if this element in the patent is given the unrestricted meaning that its language admits of, it would destroy the claim. The contention of the defendant is that it should be given the unrestricted generic meaning suggested by its broad language, and that of complainant, that the specifications should be looked to to interpret the claim, and that it should be held to mean only a protective casing of the kind and with the functions set out in the specifications. It seems that the complainant's contention is supported by the authorities cited in his supplemental memorandum and that the argument that the patent granted by the government should be construed so as to prevail rather than be forfeited, since that must have been the intention of the Patent Office, is a sound one, for limiting the breadth of the language

of the claim to the disclosure of the specifications of the patent, if necessary to sustain the patent."

Van Ness v. Layne, et al., 213 Fed. 804, 807, 808 (C. C. A. 5).

And since defendants' accused machine does not comprise any automatic stop actuated by the load itself in upward movement, it follows that the trial judge unquestionably was correct when he concluded:

"That claim 4 of the patent in suit is so restricted and limited by the disclosures of the prior art that it does not cover the structure of the carriers manufactured and sold by the defendant Willamette-Hyster Company, or used by the defendant Clark & Wilson Lumber Company." (Conclusions of Trial Judge, Tr. pp. 157, 158.)

An Additional Reason Why the Trial Judge Was Required to Limit and Restrict the Claim in Suit to the Particular Device Disclosed in the Gerlinger Patent.

During the proceedings before the Master counsel for plaintiff-appellant admitted that the elevator carrying truck shown in defendants' pamphlet, Exhibit 41, and defendants' photo exhibits 42 and 43 (Ex. Bk. pp. 945, 948 and 949) is *not* an infringement of claim 4 in suit (Tr. p. 444). And yet the machine of such exhibits is a complete response to claim 4. The color scheme of such exhibits is the same as the one used in defendants' charts appearing in this brief. Therefore, your Honors will experience no difficulty if you care to apply the claim to the machine depicted by such exhibits 41, 42, and 43. On this point the Master said:

"The plaintiff has to a large degree confined the field of inquiry and consideration by stipulating that the defendant's front-end hoist does not infringe the patent.

"This carrier (shown in Exhibits 41, 42 and 43) is a

carrier adapted to hoisting, transporting, lowering and depositing lumber. It comprises (1) a frame, (2) load lifting means mounted therein, means for transmitting motion from a source of power to the load lifting means comprising (3) a clutch that can be operated manually and set in neutral position or so set as to cause the load lifting means to move in either direction, (4) means for manually moving the clutch to operative position, (5) automatic means for moving the clutch to neutral position upon movement of the load lifting means to a pre-determined extent in either direction and means for braking the transmission means whenever the clutch is moved to neutral.

"In fact many of the parts comprising the automatic stop and braking means are interchangeable with those on the straddle type carrier manufactured by defendant, which plaintiff contends infringes his patent." (Master's Report, Tr. pp. 72, 73.)

And on this same point the trial judge has found:

"17. That because of the record admission by the plaintiff during the course of the trial that defendant Williamette-Hyster Company's front end carrier shown in photographs identified as defendants exhibits 42 and 43 does not constitute an infringement of claim 4 of the patent in suit, there being verbal correspondence between the claim and the said front end carrier, it follows that the invention defined by claim 4 of the patent in suit must be restricted to the form of load actuated mechanism for moving the clutch shown and described by the patentee Carl F. Gerlinger."

"18. That that which was in fact the invention of the patentee Carl F. Gerlinger was an automatic stop actuated by the load itself in upward movement, and an automatic stop controlling the downward movement of the kind and character shown by his drawings and specification." (Findings of Fact, Tr. pp. 151-152.)

Thus on the admission of counsel for plaintiff-appellant the claim in suit does not cover a machine on which it clearly reads,—a machine which, as a matter of fact, has

parts which are *interchangeable* with that one of the Williamette-Hyster machines which plaintiff-appellant has chosen to charge with infringement of the patent in suit.

The claim in suit reads upon the machine of Exhibits 41, 42, and 43 in the same way that it reads upon the accused machine. Each and every word in the claim has the same meaning when applied to either of such machines that it does when applied to the other.

Since counsel disavowed the apparent breadth of the claim in suit, the court naturally restricted and limited the claim to the particular machine shown in the patent drawings,—that machine which comprises, *inter alia*, the load actuated stop member 67 which was Gerlinger's only novel contribution to an otherwise very old aggregation of truck and elevator elements.

Assuredly the trial court did not err in so doing.

The Defense of Invalidity for Lack of Invention and the Evidence Required to Establish It Are Separate and Distinct from the Defense of Anticipation.

As the above proposition received some discussion in the proceedings before the trial court, we now cite our cases in support thereof:

Thompson v. Boisselier, 114 U. S. 1, 11, 12, 13.

Gardner v. Herz, 118 U. S. 180, 190, 191, 192.

Klein v. City of Seattle, 77 Fed. 200, 204, 205
(C. C. A. 9).

Keszthelyi v. Doheny Stone Drill Co., 59 Fed.
(2d) 3, 8 (C. C. A. 9).

Reinharts, Inc. v. Caterpillar Tractor Co., 85 Fed.
(2d) 628, 630 (C. C. A. 9).

The Prior Art in Evidence Is Analogous to the Art to Which the Patent in Suit Pertains and Is Wholly Adequate to Show Lack of Invention in the Combination of the Claim in Suit.

In this case counsel for plaintiff-appellant has taken the position, which to us seems quite absurd, that a truck and elevator aggregation, suitable for carrying lumber, which happens to be called a "lift truck," is not in an art analogous with a truck and elevator aggregation, which happens to be called a "straddle truck."

In this connection the attention of your Honors is called to the following cases and the analogies of which they treated:

Concrete Mixer and Improvement in Apparatus for Mixing Tea and Other Material Held to Be in Analogous Arts.

Ransome Concrete Machinery Co. v. United Concrete Machinery Co., 177 Fed. 413 (C. C. A. 2).

Patent for Preserving Fish Held Invalid Over Patent for Corpse Preserver.

Brown v. Piper, 91 U. S. 37.

Apparatus for Elevating and Distributing Concrete or Other Plastic Material Held Devoid of Invention in View of Similar Apparatus for Handling Grain, Coal, etc.

Concrete Appliances Co. et al. v. Gomery et al., 291 Fed. 486 (C. C. A. 3); affirmed 269 U. S. 177.

Child's Savings Bank Anticipated by Animal Trap.

W. F. Burns Co. v. Mills et al., 143 Fed. 325-328 (C. C. A. 7).

Patent for Drive Gearing for Speedometer Held Void for Lack of Invention in View of Prior Use of Similar Device in Dental Machines, Shearing Machines, Etc.

Warner Instrument Co. v. Stewart & Clark Mfg. Co., 185 Fed. 507 (C. C. A. 7).

Patent for Apparatus for Pasteurizing Beer Held Anticipated by Apparatus for Curing Fish.

Model Bottling Machinery Co. v. Anheuser-Busch Brewing Ass'n., 190 Fed. 573 (C. C. A. 8).

Portable Elevator Intended Particularly for Elevating Commodities in Sacks, Bales, Etc., Held Devoid of Invention in View of Straw Stacker.

Brown Portable Elevator Co. v. Interior Warehouse Co., 234 Fed. 649 (D. C. Oregon).

Those of the Prior Patents in Evidence Which Were Not Pleaded in the Answer But Offered to Show the State of the Art Are Competent and Relevant Evidence of Invalidity Because of Lack of Invention.

Since the above proposition is one which was accorded some discussion in the trial court, we are citing our authorities in support of it.

Myers v. Sternheim, 97 Fed. 625, 626 (C. C. A. 9).

Barkis v. California Almond Growers' Exchange, 17 Fed. (2d) 327, 328.

United States Consol. Seeded Raisin Co. v. Selma Fruit Co., 195 Fed. 264, 267, 268 (C. C. A. 9).

Johnson v. Lambert, 234 Fed. 886, 888, 889 (C. C. A. 2).

Jones v. Cyphers, 126 Fed. 753, 754, 755 (C. C. A. 2).

Dunbar v. Myers, 94 U. S. 187, 198, 199.

The Introductory Clause of the Claim in Suit Is Not an Element of the Claimed Combination and Does Not Serve to Differentiate Such Combination from the Prior Art.

Counsel for plaintiff-appellant seems to take the unusual position that the words "A lumber carrier," constituting the introduction to claim 4 in suit, have the dual function

of (1) carrying into that claim anything and everything, patentable or otherwise, which is common to the drawings of the patent in suit and the accused machine, and (2) of excluding from the claim anything and everything in the disclosure of the patent in suit which is not found in the accused device.

Therefore, we cite our authorities showing that such introductory words have no such effects as counsel for plaintiff-appellant seems to attribute to them.

Eclipse Mach. Co. v. J. H. Specialty Mfg. Co.,
4 Fed. Supp. 306, 315.

Langmuir v. DeForest, 18 Fed. (2d) 345, 346;
affirmed 21 Fed. (2d) 918 (C. C. A. 3).

W. W. Sly Mfg. Co. v. Russell & Co., 189 Fed.
61, 65 (C. C. A. 6).

Diamond Drill & Machine Co. v. Kelly Bros., 120
Fed. 289, 293.

Frederick R. Stearns & Co. v. Russell, 85 Fed.
218, 224 (C. C. A. 6).

Ford Motor Co. v. Parks & Bohne, 21 Fed. (2d)
943, 946 (C. C. A. 8).

*Nye Tool & Machine Works v. Crown Die & Tool
Co.*, 292 Fed. 851, 853 (C. C. A. 7).

The Similarity or Difference Between the Patented Structure and the Prior Art Is Not to Be Judged by the Names Applied to Such Structure, But by the Much More Fundamental Test of the Work Performed by Each.

In support of the last stated proposition we cite the following authorities:

Machine Co. v. Murphy, 97 U. S. 120.

Bates v. Coe, 98 U. S. 31, 42.

“Parts of speech must yield to parts of iron and brass.”

Beach v. Inman, 75 Fed. 840, 842.

**The Findings of the Trial Court, Unless Clearly Wrong,
Should Not Be Disturbed.**

In this case the Master, being the experienced and capable standing Master of the trial court, saw and heard the witnesses and inspected the machines with which this litigation is concerned. Then such Master filed a report of remarkable clarity and soundness. Thereafter the trial judge personally went deeply into the case, reviewed the evidence, and considered the oral and written arguments of counsel. After so doing, the trial judge approved the Master's report, wrote a confirming opinion, and independently made a very complete set of Findings of Fact, followed by Conclusions of Law, which are absolutely conclusive of this case on two grounds, *i. e.*, non-infringement and laches.

With respect to the findings of the trial judge, we submit that:

"His findings, unless clearly wrong, should not be disturbed. *Adamson v. Gilliland*, 242 U. S. 350, 353, 37 S. Ct. 169, 61 L. Ed. 356; *Diamond Patent Co. v. Webster Bros.*, (C. C. A. 9) 249 F. 155, 158; *Central California Canneries Co. v. Dunkley Co.*, (C. C. A. 9) 247 F. 790, 794. See, also, *Collins v. Finley*, (C. C. A. 9) 65 F. (2d) 625, 626; *Easton v. Brant*, (C. C. A. 9) 19 F. (2d) 857, 859."

Reinharts, Inc. v. Caterpillar Tractor Co., 85 Fed. (2d) 628, 630 (C. C. A. 9).

Certainly the rule in the case last quoted must apply with even greater force in cases, like the one at bar, where counsel for plaintiff-appellant makes no direct attack, or even no plain attack by indirection, upon any fact findings of the trial judge.

Laches Is a Complete Bar to This Suit.

In the "STATEMENT OF THE FACTS" appearing at the beginning of this brief, we have set forth at length that portion of the Master's report (Tr. pp. 79-86) which discusses the defense of laches, and in such statement we also set forth certain portions of the trial court's opinion (Tr. pp. 141-142) treating of the same defense.

We now set forth, with our own emphasis, those findings, and that conclusion, of the trial judge which are concerned with the subject of laches. We begin at page 153 of the transcript.

"24. That the patent in suit, Letters Patent No. 1,457,025, issued May 29, 1923 on an application filed March 30, 1922, and that plaintiff's *bill of complaint* herein was exhibited *October 3, 1935*.

25. That as early as *September, 1923*, defendant Clark & Wilson Lumber Company purchased two Ross carriers, both of which have ever since been in constant use; that each of these carriers is a straddle type with load lifting means mounted in the frame between the wheels, the lift having four lifting points that work positively and in unison; that each carrier is equipped with a manually operated clutch which can be placed in neutral and which can be operated to move the lift in either direction; that each carrier has means which, when the lift has reached a pre-determined point in upward or downward movement, moves the clutch into neutral position and applies a brake to the load lifting means.

26. That the device alleged to infringe claim 4 of the patent in suit was first designed and constructed by the Willamette Iron & Steel Company in *September, 1926*; that the defendant Willamette-Hyster Company succeeded to the carrier business of the former in 1929; and that both companies, during their respective periods of operation, continuously manufactured and sold the alleged infringing device.

27. That the gross amount of defendant Willamette-Hyster Company's sales of the alleged infringing carrier is approximately \$2,000,000.00.

28. That the market for straddle type carriers is largely confined to saw mills and lumber yards; *that the competitive field is largely occupied by Ross, defendant Willamette-Hyster Company, and plaintiff; that the competition between them is and has been keen;* that at least as early as December, 1925, the Ross company advertised its carriers in the trade journals; that the machines of the defendant Willamette-Hyster Company and its predecessor, Willamette Iron & Steel Company, have been advertised in trade journals and in public use since September, 1926; that when in use these carriers travel through lumber yards and over loading platforms, and often upon the public highways; *that in each type of machine the automatic stops are in plain view and the automatic brake is likewise visible to casual inspections by anyone having occasion to visit the mill plant;* that under such circumstances each competing manufacturer must have attained accurate and complete knowledge of the structure employed by the others; that the circumstances were such as to put the plaintiff upon inquiry; *that if plaintiff was in fact ignorant of the alleged infringement, it failed to use reasonable diligence to inform itself of all of the facts;* that there is imputed to the plaintiff accurate and complete knowledge of the structural details of the alleged infringing devices, and an awareness that said alleged infringing devices embodied and/or employed the alleged invention broadly defined by the terms of claim 4 of Letters Patent No. 1,457,025.

29. That plaintiff has failed to sustain the burden of disclosing any impediment to earlier action or of showing how it could have remained ignorant of its rights for so long a period of time, or of showing that it was ignorant of the alleged infringement. *It is found, therefore, that plaintiff had knowledge of the alleged infringement of defendants for more than six (6) years prior to the bringing of this suit."*

"30. That if defendant Clark & Wilson Lumber Company had knowledge of said Gerlinger patent No. 1,457,025, its knowledge was constructive only; that defendant Willamette-Hyster Company had knowledge of said Gerlinger patent.

31. *That by its failure to give notice of infringe-*

ment and failure to act, plaintiff has permitted defendant Clark & Wilson Lumber Company to expend large sums of money in the purchase of allegedly infringing machines and to use said machines constantly without objection during a period commencing over twelve (12) years prior to the bringing of this suit.

32. *That by its failure to give notice of infringement and failure to act, plaintiff has permitted defendant Willamette-Hyster Company (and its predecessor in interest, Willamette Iron & Steel Company) to invest large sums of money in the development, manufacture, and distribution of its carriers, making no objection for approximately nine (9) years prior to the commencement of this suit.*

33. That even if infringement existed as alleged, *plaintiff is guilty of laches with relation to each of the defendants.*" (Findings of Fact, Tr. pp. 153-156.)

"11. That the plaintiff Dallas Machine & Locomotive Works, Inc., is guilty of laches for its long neglect to assert any right against these defendants and is barred from any recovery in this suit." (Conclusions of Law, Tr. p. 159.)

As the trial court said:

"While the case of *Gillons, et al. v. Shell Co. of California*, 86 F. 2d, 600, may have distinguishing features, *the principle is applicable here.*" (Opinion of Trial Judge, Tr. p. 142.)

We, for defendants-appellees, respectively submit that the principles announced by this Ninth Circuit Court of Appeals in the Gillons case, are controlling with respect to the case at bar.

In the Gillons case your Honors said:

"At the outset, it will be helpful that we place our inquiry into its proper setting. It must be borne in mind that the decision of the trial court on the subject of laches will not be set aside unless it is palpably wrong.

In *The Kermit*, 76 F. (2d) 363, 367, certiorari denied, *Lamborn v. American Ship & Commerce Nav. Co.*, 296 U. S. 581, 582, 56 S. Ct. 93, 80 L. Ed. 411, we said: 'As the decisions indicate, the question of laches is ad-

dressed to the sound discretion of the trial judge, and his decision will not be disturbed on appeal unless it is so clearly wrong as to amount to an abuse of discretion.' " (p. 604.)

In the case at bar the findings and conclusions of the trial court are not palpably wrong. They are correct and just. In the case at bar the trial judge has not been guilty of an *abuse of judicial discretion*. The trial judge, at all times, was most solicitous of the rights of appellant,—deciding the case against appellant, on the laches issue, only because compelled to do so by the proven facts and the law of this circuit applicable to such facts. Moreover, and as pointed out at earlier points in this brief, plaintiff-appellant has not made any direct attack, or any very plain attack by indirection, upon any of the Findings of Fact made by the trial judge,—although, of course, appellant does not relish the Conclusions, logically and necessarily following such fact findings, which required the dismissal of this suit.

And in the Gillons case this court said:

"When the suit is filed *after* the statutory period, injury is presumed. In *McGrath v. Panama R. Co.* (C. C. A. 5) 298 F. 303, 304, the court said: 'The appellant suggests that no injury is shown to have been done to the appellee by the delay in filing the libel. Injury is presumed from the statutory period of limitations in common-law actions, and, when equity adopts the statutory period, it adopts along with it the presumption of injury, until the contrary is shown.' See, also, *Westfall Larson & Co. v. Allman-Hubble Tug Boat Co.* (C. C. A. 9) 73 F. (2d) 200, 203.

In the patent cases, the 'analogous' statutory period is six years." (Citing cases.) (p. 608.)

In the case at bar appellee Clark & Wilson Lumber Company continuously was using machines of the character said to be covered by the claim in suit for over *twelve years* prior to the filing of the bill of complaint (Finding 31, Tr. p. 156), and appellee Willamette-Hyster Company,

and its predecessor, were investing money for, and were making and distributing, machines of the character said to be covered by the claim in suit, for a period of over nine years prior to the commencement of this suit.

And in the Gillons case, this court also said:

"It is precisely because equity recognizes this *frailty of human memory* that she has launched her canon against unreasonable delay in bringing suit. Gillons is not to be penalized for his faulty recollection. He is, however, responsible for having stood idly by for so long a period that he can no longer recapture the misty memories of another day—memories that have, perhaps, vanished as completely as the snows of yesteryear." (p. 609)

In the case at bar Mr. Gerlinger, President of the appellant company, avoided much interrogation, as to matters directly relating to the defense of laches, by averring poor memory on account of lapse of time.

For example:

"Q. Who was it that reported the fact to you a year or two after Clark & Wilson bought your hydraulic carriers that they were using Ross carriers at their plant?

A. *I couldn't say that.*

Q. Is it your testimony that no one ever reported to you anything concerning the construction and operation of the Ross carriers in use by the defendant Clark & Wilson Lumber Company at or after the time that you sold Clark & Wilson your hydraulic carriers?

A. Oh, I wouldn't say that, but *I don't remember.*

Q. As a matter of fact, Mr. G. A. Grab, who was then working for you, called your attention to the fact that Clark & Wilson were using Ross carriers, didn't he?

A. That might be true, but *I don't remember he did.*" (Tr. pp. 427, 428.)

The case at bar is just another one of those cases, characterized by long and unreasonable delay in bringing suit,

where the plaintiff chose not to remember, or may have forgotten, facts which at the time of trial were inimicable to the maintenance of the action.

In general with respect to the defense of laches, and disregarding the specific facts of the case then under decision, your Honors, in the Gillons case, said:

"To sustain the lower court's findings of laches in the instant case, however, it is not necessary to rely upon the foregoing special considerations, or upon estoppel, or even upon the 'analogous' statute of limitations. There is another and all-embracing principle that amply justifies the District Judge's exercise of discretion.

Equity frowns upon stale demands. She will not aid one who has slept upon his rights. She turns her back upon a litigant who has been guilty of unreasonable delay in filing suit.

In a line of decisions extending farther back than a century, our Supreme Court has recognized this equitable doctrine, as being grounded upon considerations of 'the peace of society' and of 'public convenience.' In *Piatt v. Vattier*, 9 Pet. 405, 416, 417, 9 L. Ed. 173, Mr. Justice Story said: 'The established doctrine, or, as Lord Redesdale phrased it, in *Hovenden v. Annesley*, 2 Sch. & Lef. 637-8, 'the law of courts of equity,' from its being a rule adopted by those courts, independent of any positive legislative limitations, is, that it will not entertain stale demands. Lord Camden, in *Smith v. Clay*, 3 Bro. C. C. 640, note, stated it in a very pointed manner. 'A court of equity,' said he, 'which is never active in relief against conscience or public convenience, has always refused its aid to stale demands, where the party has slept upon his rights, or acquiesced for a great length of time. *Nothing can call forth this court into activity, but conscience, good faith and reasonable diligence.* Where these are wanting, the court is passive and does nothing; laches and neglect are always discountenanced; and therefore, from the beginning of this jurisdiction, there was always a limitation of suits in this court.'

Again in *Wagner v. Baird*, 7 How. 234, 258, 12 L. Ed. 681, the court said:

'But there is a defence peculiar to courts of equity, founded on lapse of time and the staleness of the claim, where no statute of limitations directly governs the case. In such cases courts of equity often act upon their own inherent doctrine of discouraging, for the peace of society, antiquated demands, by refusing to interfere where there has been gross laches in prosecuting rights, or long acquiescence in the assertion of adverse rights. (2 Story Eq. 1520.)

'A court of equity will not give relief against conscience or public convenience where a party has slept upon his rights.'

See, also, *McLean v. Fleming, supra*, (citing long list of cases) * * *

"In connection with the bar of laches, from the earliest days federal courts have emphasized the distinction between a reasonable and an unreasonable delay in bringing suit—even *within* the period designated by the statute of limitations.

In *Patterson v. Hewitt, supra*, 195 U. S. 309, at page 318, 25 S. Ct. 35, 37, 49 L. Ed. 214, Mr. Justice Brown used the following language: 'But where the statute is in terms applicable to suits in equity, as well as at law, it is ordinarily construed, in cases demanding equitable relief, as fixing a time beyond which the suit will not, under any circumstances, lie; but not as precluding the defense of laches, provided there has been unreasonable delay within the time limited by the statute. In an action at law, courts are bound by the liberalism of the statute; but in equity the question of unreasonable delay within the statutory limitation is still open. (Cases cited.)

In *Prince's Metallic Paint Co. v. Prince Manuf'g. Co.* (C. C. A. 3), 57 F. 938, 944, the court said: 'In courts of equity the rule is to withhold relief where there has been unreasonable delay in prosecuting a claim, or long acquiescence in the assertion of adverse rights. (Cases cited.) Again and again has it been judicially declared that nothing can call into activity a court of equity but 'conscience, good faith, and reasonable diligence.' (Cases cited.) In *McLaughlin v. Railway Co.* (C. C.), 21 F. 574, Judge Brewer held a bill for the infringement of a patent, alleging the unauthorized use and construction of a patented invention

for 13 years, without stating an excuse for the plaintiff's delay in suing, to be demurrable. Laches for even less than the statutory period of limitations, aided by other circumstances, will bar a right. (Case cited.)'

In *Miles v. Vivian* (C. C. A. 2), 79 F. 848, 853, the court said: 'Independently of any statute of limitations, courts of equity uniformly decline to assist a person who has slept upon his rights unreasonably long, and shows no excuse for having done so.'

And in more recent days, in the case of *Window Glass Mach. Co. v. Pittsburgh Plate Glass Co.* (C. C. A. 3), 284 F. 645, 650, certiorari denied, 261 U. S. 623, 43 S. Ct. 518, 67 L. Ed. 832, the following language was used:

'The circumstances were such, without repeating them at length, that the plaintiffs knew or were chargeable with knowledge of the practices and the apparatus employed by the defendant at its several works during these periods. (Cases cited.) On these facts and circumstances the defendant makes the defense of laches.

'This defense is based on a well-settled principle of law. In its application courts recognize the general rule that, in a case of this kind, mere delay, unaccompanied by anything else, will not ordinarily bar a suit for injunction against a naked infringer. (Cases cited.) But they also recognize a distinction between *mere delay* and *unreasonable delay*, where in the latter is involved the element of lack of diligence and the consequent inequity, under the circumstances, of permitting the *claim* to be enforced.' (Italics our own) (pp. 609, 610.)

Surely, upon the basis of the facts presented in the case at bar, and in view of the principles laid down in the Gillons case, the court below was justified in holding—had no choice other than to hold—that laches is "a complete bar" to this suit.

Laches Is a Bar to Both Injunctive and Compensatory Relief.

We believe that the principles stated in the *Gillons* case, *supra*, and the application of such principles in that case, are ample authority for the proposition that gross laches, of the kind presented in the case at bar, will preclude both injunctive and compensatory relief. However, we shall now cite other cases in support of such proposition, quoting short excerpts from some of them.

“During all of the time from 1920 to the date of the filing of the bill of complaint the defendant was openly, not secretly, engaged in manufacturing what is now claimed is an infringement, without any action being taken on the part of the owner of the patent, even the giving of notice, until shortly before the commencement of this action.

“Laches of this character is such as will prevent a court of equity from entertaining the bill.”

Cinema Patents Co. v. Duplex Motion Picture Industries, 60 Fed. (2d) 1013, 1019 (D. C., E. D. N. Y., Feb. 2, 1932—Campbell, D. J.).

“This is not a defense of estoppel, but of *laches*, and it would be inequitable to now hold the defendant, but a short time before the patents expire, who bought this machine almost seven years after it was put into open, public, not secret, use during which time no suit for infringement had been commenced, and openly used the machine for over five years after such purchase before any suit was commenced.

“While it may be that knowledge has not been established sufficient to warrant the application of the doctrine of estoppel, it seems clear to me that, on the evidence before this court, the doctrine of laches applies. *Triplex Safety Glass Co. v. Kolb*, 53 F. (2d) 1062, opinion of Kirkpatrick, J., D. C., E. D. Pa., June term, 1931.

“Certainly the owners of these patents have slept on their rights, and I believe there has been acquiescence in the alleged infringement. If the owners of

the patents had proceeded diligently to protect their rights, it is hard to believe defendant would have purchased the machine, and the court should not entertain this complaint. *Kittle v. Hall* (C. C.), 29 F. 508, 511."

Cinema Patents Co. v. Warner Brothers Pictures,
55 Fed. (2d) 948, 959, 960 (D. C., E. D. N. Y.,
Fed. 2, 1932—Campbell, D. J.)

"A concise and generally accepted definition meeting with favor is worded thus: 'Laches, in legal significance, is not mere delay, but delay that works a disadvantage to another.' *Chase v. Chase*, 20 R. I. 202, 37 A. 804."

* * * *

"We think, therefore, that there is justification in patent suits for withholding damages for infringements committed prior to the commencement of the suit when laches is established, notwithstanding injunctive relief be granted. But, when it can be shown that the holder of the patent in addition to being guilty of laches has, by his conduct, estopped himself from asserting his rights under the patent, *all relief should be denied and the bill dismissed.*"

George J. Meyer Mfg. Co. v. Miller Mfg. Co., 24 Fed. (2d) 505, 507, 508 (C. C. A. 7—Feb. 23, 1928—Evan A. Evans, C. J.).

"As we are of opinion that the decree of the District Court dismissing the bill should be affirmed upon the merits, it is unnecessary that we consider the special defenses pleaded in the answer. *It may not be amiss to observe, however, that the laches shown by the record would be quite sufficient of itself to bar complainant of relief in this case.*" * * * *,

Wolf Mineral Process Corp. v. Minerals Separation N. A. Corp., 18 Fed. (2d) 483, 490 (C. C. A. 4—April 12, 1927—Parker, C. J.).

"When delay in prosecuting a claim is so unusual as to carry with it the appearance of being unreasonable, as in this case, there develops upon a plaintiff the burden of disclosing the impediments to an earlier

action; of showing, if ignorant of his rights, how he had remained in ignorance so long; and of revealing how and when he first came to a knowledge of the matters on which he relies in his bill for relief.

* * *,,

* * * * *

“Feeling that the plaintiffs have not sustained the burden which the law placed upon them on the issue of laches, *we affirm that part of the decree by which the trial court dismissed the bill as to the Lubbers patents Nos. 702,013, 702,014 and 702,015.*”

Window Glass Mach. Co. v. Pittsburgh Plate Glass Co., 284 Fed. 645 (C. C. A. 3).

“* * * The complainant and the patentee, who has an interest in this litigation, are guilty of laches, *and have thereby lost any right they might have had against the defendant.* This point alone is dispositive of the case and justifies denial of the relief sought.”

Yates v. Smith, 271 Fed. 27, 32, 33 (D. C., D. N. J., May 15, 1920—Davis, D. J.).

“I am of opinion that equity as applied to modern business developments requires that, in this particular case, injunctive relief in any event be denied.

* * *,,

* * * * *

“That complainant, in any event, would not be entitled to an accounting, is clear under the authority of *Menendez v. Holt, supra*, and *Mosler v. Lurie*, and for the reasons outlined I am also satisfied *complainant is not entitled to prevail on any theory.*”

Valvoline Oil Co. v. Havoline Oil Co., 211 Fed. 189, 195 (D. C., S. D. N. Y., Dec. 23, 1913—Mayer, D. J.).

“* * * This lapse of time not only constitutes a bar, such as the statute of limitations interposes, but shows such *laches as will clearly preclude any right to relief.* * * *,,

Cummings v. Wilson & Willard Mfg. Co., et al., 4 Fed. (2d) 453, 455 (C. C. A. 9—Jan. 26, 1925—Ross, C. J.).

"The question of laches then assumes the aspect of the plaintiff having stood by and having done nothing to protect its rights for seven years while the defendant was building up a business, which it thought was legitimate, and spending money in constructing a large plant."

* * * *

"We think that the evidence clearly shows the delay, during which the defendant materially changed its position, to be inexcusable. *Consequently, we cannot say that the District Judge erred in refusing an injunction and an accounting.*"

Westco-Chippewa Pump Co. v. Delaware Electric & S. Co., 64 Fed. (2d) 185, 186, 187, 188 (C. C. A. 3—March 17, 1933—Davis, C. J.).

See, also:

Dwight & Lloyd Sintering Co. v. Greenawalt, 27 Fed. (2d) 823, 826, 827 (C. C. A. 2—August 20, 1938—L. Hand, C. J.).

Universal Arch Co. v. American Arch Co., 290 Fed. 647, 653 (C. C. A. 7—Sept. 28, 1922—Rehearing denied May 8, 1923—*Per Curiam*).

Woodmanse & Hewitt Manufacturing Co. v. Williams, 68 Fed. 489, 491, 492 (C. C. A. 6—June 4, 1895—Lurton, C. J.).

Mere Delay Unaccompanied by Any Change of Position by Defendant in Reliance Upon Plaintiff's Conduct Is Sufficient to Justify Dismissal of the Bill of Complaint.

Cases other than *Gillons, supra*, supporting the proposition last stated, are as follows:

Window Glass Mach. Co. v. Pittsburgh Plate Glass Co., 284 Fed. 645, 659 (C. C. A. 3). Certiorari denied 261 U. S. 623.

Wilkie v. Manhattan Rubber Mfg. Co., 8 Fed. (2d) 785, 788. Affirmed 14 Fed. (2d) 811 (C. C. A. 3).

- Cinema Patents Co., Inc. v. Duplex Motion Picture Industries, Inc.*, 60 Fed. (2d) 1013, 1018, 1019. Affirmed 66 Fed. (2d) 748 (C. C. A. 2).
- Hall v. Frank*, 195 Fed. 946.
- Thacher v. Board of Supervisors of Polk County, Iowa*, 235 Fed. 724, 727, 728.
- Wolf Minerals Process Corp. v. Minerals Sep. North American Corp.*, 18 Fed. (2d) 483, 490 (C. C. A. 4).
- Meyer Mfg. Co. v. Miller Mfg. Co.*, 24 Fed. (2d) 505, 506, 507, 508 (C. C. A. 7).
- Dwight & Lloyd Sintering Co., Inc. v. Greenawalt*, 27 Fed. (2d) 823, 827 (C. C. A. 2).

Alleged Lack of Knowledge of the Acts Complained of Does Not Excuse Laches When Reasonable Diligence Would Have Provided Such Knowledge.

Additional authorities supporting the proposition last stated are as follows:

- Foster v. Mansfield*, 13 Sup. Ct. 28, 32, 33.
- Johnston v. Standard Min. Co.*, 13 Sup. Ct. 585, 589.
- Woodmanse & Hewitt Mfg. Co. v. Williams, et al.*, 68 Fed. 489, 491, 492, 493 (C. C. A. 6).
- Window Glass Mach. Co. v. Pittsburgh Plate Glass Co.*, 46 Fed. (2d) 484, 489. Affirmed 284 Fed. 645 (C. C. A. 3).
- Safety Car Heating & Lighting Co. v. Consolidated Car Heating Co.*, 160 Fed. 476, 493, 494. Affirmed 174 Fed. 658 (C. C. A. 2).
- Brown & Sharpe Mfg. Co. v. Coates Clipper Mfg. Co.*, 195 Fed. 84, 87.
- A. R. Mosler & Co. v. Lurie*, 209 Fed. 364, 370, 371 (C. C. A. 2).

The Claim in Suit Attempts to Cover an Exhausted Combination and, Therefore, Is Void Under the Doctrine Recently Stated and Re-Stated by the Supreme Court in Bassick v. Hollingshead and Lincoln v. Stewart Warner.

In *Bassick v. Hollingshead*, 89 L. ed. 1251, 298 U. S. 415 (1936) the Supreme Court condemned claims for exhausted combinations. The court, at page 425, said:

“The question then is whether, by this method, the patentee, by improving *one element* of an *old combination* whose construction and operation are otherwise unchanged, may, in effect, *repatent* the old combination by *reclaiming it* with the improved element substituted for the old element. That this cannot be done is shown by numerous cases in this and other federal courts.”

Specifically this meant that the *combination* of a grease cup and a grease pump being old, the exhausted combination between the cup and the gun could not validly be repatented by one who had made some specific improvement in one or the other of the old elements of the exhausted combination.

This rule seemingly did violence to what many patent lawyers (and courts) thought was proper claim drafting,—and it was necessary for the Supreme Court to restate and amplify the rule.

So in *Lincoln v. Stewart Warner*, 82 L. Ed. 1008, 303 U. S. 544 (1938), we find the Supreme Court saying:

“As the Circuit Court of Appeals held, a headed nipple or fitting connected with the bearing, and to be coupled to the conduit from the grease gun, is old and unpatentable. A compressor or pump for propelling lubricant is old and unpatentable as such. *The invention, if any, which Butler made was an improvement in what he styles in his specifications the ‘chuck’ and in his claim a ‘coupling member.’* It is not denied that multi-jawed chucks had been used in industry and as couplers in lubricating apparatus. Butler may have devised a patentable improvement in

such a chuck in the respect that the multiple jaws in his device are closed over the nipple by the pressure of the grease, but we think he did no more than this. As we said of Gullborg in the Rogers Case, having hit upon this improvement he did not patent it as such but attempted to claim it in combination with *other old elements which performed no new function in his claimed combination.* The patent is therefore void as claiming more than the applicant invented. The *mere aggregation* of a number of old parts or elements which, in the *aggregation*, perform or produce no new or different function or operation than that theretofore performed or produced by them, *is not patentable invention.* And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts *which perform no new function in the combination.*

* * * * *

We conclude that Butler's effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of chuck or coupler to old parts or elements having no new function when operated in connection with the coupler renders the claim void."

So squarely does the last quoted language of the Supreme Court fit Gerlinger's claim in the case at bar, that it may be paraphrased as follows:

As the trial judge held, *an elevator mounted on a truck, and to be included in driven relation to the truck power plant,* is old and unpatentable. *A truck—yea a straddle truck—for carrying an elevator* is old and unpatentable as such. The invention, if any, which Gerlinger made was an improvement in what he styles in his specifications the "*lifting device.*" It is not denied that *lifting devices* had been used in industry and as *elevators in lumber carriers.* Gerlinger may have devised a patentable improvement in such a *lifting device* in the respect that it *comprises a load actuated stop member 67,* but we think he did no more than this. As we said of Gullborg in the Rogers (Hollingshead) Case, having hit upon this improvement he did not patent it as such, but attempted to claim it in combination with other old

elements which performed no new function in his claimed combination. The patent is therefore void as claiming more than the applicant invented. The mere aggregation of a number of old parts or elements which, in the aggregation, perform or produce no new or different function or operation than that theretofore performed or produced by them, is not patentable invention. And the improvement of one part of an old combination gives no right to claim that improvement in combination with other old parts which perform no new function in the combination.

* * * * *

We conclude that *Gerlinger's* effort, by the use of a combination claim, to extend the monopoly of his invention of an improved form of *lifting device* to old parts or elements having no new function when operated in connection with the *elevator* renders the claim void. (In this paraphrase the italicized matter is ours.)

Graphically to demonstrate that the Gerlinger claim in suit attempts to cover an exhausted combination, just as did the Butler claim in *Lincoln v. Stewart-Warner*, we present opposite this page a chart whereon the recitals of the invalidated Butler claim are presented in contrast to the recitals of the invalid Gerlinger claim. On ~~such each~~^{SUCH} chart, the language of each claim is divided between two rectangles,—one of such rectangles containing the words of the claim which are descriptive of the *unimproved* element or component of the exhausted combination, and the other rectangle containing the words of the claim descriptive of the allegedly *improved* element or component of the exhausted combination.

Thus on the chart, Butler's *unimproved* nipple corresponds with Gerlinger's *unimproved* truck; and Butler's allegedly *improved* grease compressor corresponds with Gerlinger's allegedly *improved* elevator.

The combination (or more properly aggregation) of a truck and an elevator carried on the truck was old long

BUTLER PATENT

(LINCOLN vs. STEWART-WARNER)

THE EXHAUSTED COMBINATION.

(1) a headed nipple for receiving lubricant,



(2) a lubricant compressor having a coupling member for connecting said compressor and nipple comprising a cylinder, a piston movable within the cylinder, and having an aperture for the discharge of lubricant thereof, an apertured sealing seat carried by said piston for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple, radially movable locking elements carried by the cylinder coacting with the nipple and actuated by said piston for compressive-ly clutching the elements upon the nipple whereby the pressure of the lubricant on said piston will move the piston to forcibly compress said elements while the lubricant is passing through said connecting parts.

THE UNIMPROVED ELEMENT (BUTLER'S NIPPLE)

THE IMPROVED ELEMENT (BUTLER'S COMPRESSOR)

GERLINGER PATENT

(OF THE CASE AT THE BAR)

THE EXHAUSTED COMBINATION

(1) lumber carrier comprising a frame,



(2) load lifting means mounted therein, means for transmitting motion from a source of power to the load lifting means comprising a clutch that can be set in neutral position or to cause the load lifting means to move in either direction, means for manually moving the clutch to operative position, automatic means for moving the clutch to neutral position upon a movement of the load lifting means to a predetermined extent in either direction, and means for braking the transmitting means whenever the clutch is moved to neutral position.

THE UNIMPROVED ELEMENT (GERLINGER'S TRUCK)

THE IMPROVED ELEMENT (GERLINGER'S ELEVATOR)

before the application for the Gerlinger patent in suit. See Ross patent No. 1,209,209 (Ex. Bk. p. 1203); Ross patent No. 1,271,947 (Ex. Bk. p. 816); and Overlin patent No. 1,323,719 (Ex. Bk. p. 1080). See even Gerlinger's *expired* patent No. 1,422,958 (Ex. Bk. p. 805). So it appears, incontrovertibly, that the aggregation of a truck and an elevator carried by that truck was very old and well known at the time Mr. Gerlinger made the alleged invention of the patent in suit. Such *patentable combination*, if any, which there once was between the truck and elevator, was *exhausted*.

Let us see what the trial judge has said about the truck and elevator aggregation—that long exhausted combination to which Gerlinger directed the claim in suit. The judge found:

“6. That the field in which the Gerlinger invention was developed is divided into two parts, namely, that relating to *elevators* or lifting devices, and that relating to self-propelled *vehicles* or carrying devices; that except as they are disposed on or within the same frame they are entirely independent and the essential function of each respective mechanism remains unchanged; * * *” (Findings of Fact, Tr. p. 147.)

And let us not forget that Gerlinger's alleged invention was concerned only with improvement of the *elevator* element or component of the aggregation. On this point the trial judge, in his opinion, said:

“The validity of the Gerlinger patent should be first then considered in relation to the construction of *elevators*, because the essential elements of the claim in question relate to the operation of a lifting device. Every element in this device was old in that art except the member 67, which stopped the operation of the elevator by the upward pressure of the load.” (Tr. p. 133.)

Thus undubitably it appears that elevators were old; that

trucks were old; and that the aggregation of a truck and an elevator, the latter being carried by the former, was old. Mr. Gerlinger came along and allegedly improved the *elevator* element or component of the old aggregation. He made absolutely no improvement in the old straddle truck by which the allegedly new elevator was carried.

But is Mr. Gerlinger's claim 4 in suit limited to the elevator? No! Instead of claiming the elevator, which was the only thing which he improved or changed, he *reclaims* the exhausted combination of truck-and-elevator. He does this despite the fact that his allegedly improved elevator bears no relation to the truck which is in any way different from the relations borne to their respective trucks by the elevators of the straddle trucks and lift trucks of the prior art.

Consequently, we can say of the Gerlinger patent what the Supreme Court said of the Butler patent, viz.:

“The patent is therefore void as claiming more than the applicant invented.”

Some Additional Observations Concerning Appellant's Brief.

I.

Appellant's brief is replete with suggestions that an important feature of the alleged invention of the patent in suit is “rack-and-pinion mechanism” included in or associated with the load lifting means. For example, see page 4 of the brief. Appellant's counsel seems to believe that the term “rack-and-pinion mechanism” should be broadened into “positively acting mechanism” and then that such broader term should be read into the claim in suit in lieu of (for example) the limitation to the load actuated stop

which the trial court read into the claim (as being Gerlinger's only novel contribution).

Such "rack-and-pinion mechanism" is disclosed in Mr. Gerlinger's expired patent No. 1,422,958. (Ex. Bk. p. 805.) During the prosecution of the application for that patent the Examiner held, and Gerlinger agreed, that there was no invention in using rack-and-pinion mechanism in connection with the load lifting means of the straddle truck disclosed in such application. For the Examiner's holding see Ex. Bk. p. 877. Gerlinger's acquiescence was indicated by the cancellation of claim 1 (original claim 3) which claimed the use of rack bars, and necessarily their cooperating pinions, in the load lifting mechanism. (For amendment cancelling such claim see Ex. Bk. p. 879. For original claim 3 see Ex. Bk. p. 867.)

II.

The drawing appearing between pages 3 and 4 does not correspond with any exhibit.

III.

The drawing appearing between pages 9 and 10 does not represent the carrier of the patent in suit. Such drawing contains the stop members 90 and 91 which the patent does not disclose.

IV.

On the chart opposite page 15 the witness Grab is misquoted. On this same chart the quotation from the opinion of the trial court is incomplete and, therefore, misleading.

V.

No attempt is made to distinguish the facts in this case (*re laches*) from the controlling case of *Gillons v. Shell Co. of California*. Appellant's counsel attempts blithely to waive aside that pertinent and controlling case by inferring that it is one

"presenting an entirely opposite state of facts than existing in the instant case." (Brief p. 69.)

Conclusion.

Appellees submit:

1. That there should be a summary affirmance of the lower court decree because appellant has not shown, or attempted to show, error in those Findings of Fact of the trial judge which are absolutely conclusive of this case as to at least two defenses, *i. e.*, non-infringement and laches.
2. That the single claim in suit is readable in terms, and in spirit, upon each of several patented machines of the prior art, and is therefore invalid unless limited and restricted to the specific device which is exhibited by the patent in suit,—*i. e.*, unless restricted, *inter alia*, to the load actuated stop 67 which, the trial judge held, was Gerlinger's only novel contribution to the art.
3. That the claim in suit, when limited as it must be limited to save it from invalidity, is not infringed by appellees' accused machine.
4. That appellant has been guilty of laches so gross as to bar to any and all relief demanded by the Bill of Complaint.
5. That the claim in suit represents an attempt to re-patent an exhausted combination and is therefore void under the doctrine of the Supreme Court stated in *Bassick*

v. Hollingshead (*supra*) and *Lincoln v. Stewart-Warner* (*supra*).

6. That the decree of the trial court should be affirmed.

Respectfully submitted,

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For Defendants-Appellees.

